

ESTTA Tracking number: **ESTTA1105100**

Filing date: **12/30/2020**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91237315
Party	Defendant Universal Life Church Monastery Storehouse, Inc.
Correspondence Address	MICHAEL P MATESKY II MATESKY LAW PLLC 1001 4TH AVE SUITE 3200 SEATTLE, WA 98154 UNITED STATES Primary Email: <a href="mailto:trademarks@mateskylaw.com">trademarks@mateskylaw.com</a> Secondary Email(s): <a href="mailto:mike@mateskylaw.com">mike@mateskylaw.com</a> 206-701-0331
Submission	Other Motions/Submissions
Filer's Name	Michael P. Matesky, II
Filer's email	<a href="mailto:mike@mateskylaw.com">mike@mateskylaw.com</a> , <a href="mailto:litigation@mateskylaw.com">litigation@mateskylaw.com</a> , <a href="mailto:trademarks@mateskylaw.com">trademarks@mateskylaw.com</a>
Signature	/Michael P. Matesky, II/
Date	12/30/2020
Attachments	Opp. to Mot. Strike 123020.pdf(629631 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE  
MINISTRIES,

Opposer,

v.

UNIVERSAL LIFE CHURCH  
MONASTERY STOREHOUSE,

Applicant.

Opposition No. 91237315

OPPOSITION TO MOTION TO STRIKE  
APPLICANT'S REPLY

The Board should deny Opposer's motion to strike Applicant's reply brief (58 TTABVUE), and exercise its discretion to consider Applicant's reply brief, because **(a)** it was filed only 12 hours late, through no fault of Applicant, and with no prejudice to Opposer, **(b)** Opposer confirmed that it would not object on timeliness grounds, **(c)** Applicant included pages addressing newly-arisen deficiencies solely in an attempt to be more efficient. In the alternative, Applicant hereby attaches a substitute reply brief that conforms with page limitations, and simply strikes material from Applicant's original reply (with no additions).

In response to a motion to strike, it is entirely within the discretion of the Board whether and to what extent it considers a reply brief that is untimely or does not conform to page limitations. *See* TBMP § 517 ("If...a reply brief in support of the motion, is not timely filed, it may be stricken, or given no consideration, by the Board....Whether the Board decides to grant a motion as conceded or

consider the motion on its merits is a matter of discretion.”). Applicant submits that, under the present circumstances, the Board should exercise its discretion to consider Applicant’s reply.

First, as stated in Applicant’s Motion to Extend or Re-Open Reply Deadline by One Calendar Day, Applicant’s reply brief was timely served, and was filed only 12 hours late, due to an ESTTA technical glitch, through no fault of Applicant, and with no prejudice to Opposer. *See* 59 TTABVUE. Second, Opposer confirmed to Applicant that it would not object to the Applicant’s reply based on the 12-hour delay in filing caused by ESTTA unavailability, then immediately turned and did precisely that, moving to strike Applicant’s “late” reply and arguing that no extension should be granted. Matesky Decl. Ex. A; 60 TTABVUE 1-2 n.2. Such sharp practice should be discouraged.

In any event, Opposer was not prejudiced, and the Board has accepted and considered briefs in such circumstances. *See, e.g., Intel Corp. v. Wheeler-Sweet*, Opposition No. 91096517, \*5 n.3 (TTAB May 18, 1999) (non-precedential)(declining to strike brief, and noting that a one-day delay “is clearly de minimis in nature, and there is no prejudice to opposer.”); *In re Charlene Corp.*, No. 87937460, \*1 (TTAB Sept. 15, 2020) (non-precedential) (granting motion to reopen time to file appeal brief, which was filed 1-day late, and allowing submission of substitute reply brief that conforms to page limitations); *Virgin Enters. Ltd. v. Albion Motors Ford Mercury, Inc.*, Opposition Nos. 91153575, 91153612, 91154161, \*\*1-2 (TTAB Aug. 10, 2007) (non-precedential) (accepting reply brief filed one day late where there was no showing of prejudice).<sup>1</sup>

---

<sup>1</sup> Copies of unpublished cases are attached to the Matesky Declaration submitted herewith. Pin citations are to the pages as designated in such copies.

Third, Applicant's reply brief was overlength solely because it included material addressing new deficiencies that arose after Applicant filed its initial motion, namely, Opposer's service of unlabeled deposition exhibits. *See* 58 TTABVUE; Matesky Decl. Exs. B-C. Applicant sought to address such issues in its reply because they related to its original motion and because it would aid efficiency. To further such efficiency, Applicant requests that the Board exercise its discretion to (1) consider Applicant's reply, or, in the alternative, (2) consider the Applicant's substitute reply submitted herewith, which conforms with page limitations simply by removing material addressing Opposer's unlabeled deposition exhibits. *See* Matesky Decl. Exs. B-C; *In re Charlene Corp.*, No. 87937460, \*1 (allowing substitute reply). This would relieve the Board from the burden of parsing material in Applicant's original reply.

For the reasons set forth above, Applicant requests that the Board deny Opposer's motion to strike, and consider Applicant's original reply brief or substitute reply brief filed herewith.

DATED: December 30, 2020

Respectfully submitted:

MATESKY LAW<sup>PLLC</sup>

s/ Michael P. Matesky, II/

Michael P. Matesky, II  
(Washington Bar No. 39586)  
4500 9<sup>th</sup> Ave. NE, Suite 300  
Seattle, WA 98105  
Ph: 206.701.0331  
Fax: 206.702.0332  
Email: [mike@mateskylaw.com](mailto:mike@mateskylaw.com);  
[litigation@mateskylaw.com](mailto:litigation@mateskylaw.com)

Attorney for Applicant

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE  
MINISTRIES,

Opposer,

v.

UNIVERSAL LIFE CHURCH  
MONASTERY STOREHOUSE,

Applicant.

Opposition No. 91237315

DECLARATION OF MICHAEL P.  
MATESKY, II

I, Michael P. Matesky, II, declare as follows:

1. I am and at all relevant times have been counsel for Applicant in this matter.
2. I am over the age of eighteen years and otherwise competent to testify in this matter.
3. I make this declaration based on my personal knowledge.
4. Attached hereto is a true and correct copy of an email sent to me by Ben Hodges, counsel for Opposer American Marriage Ministries, stating “We do not intend to object based on the one day[delay in filing] though.”
5. Attached hereto as Exhibit B is a Substitute Reply in Support of Motion to Order Service of Testimony Depositions, Strike Opposer’s Notice of Reliance, and Extend Applicant’s Trial Period, which conforms with all page limitations.
6. Attached hereto as Exhibit C is a copy showing in redline all changes between Applicant’s original reply (58 TTABVUE) and Applicant’s Substitute Reply in Support of Motion to

Order Service of Testimony Depositions, Strike Opposer's Notice of Reliance, and Extend Applicant's Trial Period.

7. Attached hereto as Exhibit D are true and correct copies of unpublished cases cited in Applicant's Opposition to Motion to Strike.

DATED: December 30, 2020 at Seattle, Washington

s/ Michael P. Matesky, II/

Michael P. Matesky, II

# EXHIBIT A

## Mike Matesky

---

**From:** Ben Hodges <ben.hodges@foster.com>  
**Sent:** Wednesday, December 09, 2020 1:43 PM  
**To:** Mike Matesky; Nancy Stephens; Kelly Mennemeier  
**Cc:** Michael Galletch  
**Subject:** RE: Reply in Support of Motion to Strike/Extend

Mike,

I don't think we can consent to the filing of the brief as we have other objections to the brief, so we don't think we can consent to the filing of it regardless of timing. We do not intend to object based on the one day though.

Thanks.

Ben

**Ben Hodges**  
**Principal**

Foster Garvey PC  
*Tel:* 206.447.6282  
ben.hodges@foster.com

---

**From:** Mike Matesky [mailto:mike@mateskylaw.com]  
**Sent:** Wednesday, December 09, 2020 9:01 AM  
**To:** Nancy Stephens; Ben Hodges; Kelly Mennemeier  
**Cc:** Michael Galletch  
**Subject:** RE: Reply in Support of Motion to Strike/Extend

Counsel,

I was able to file the brief this morning (unchanged from the version I served last night). Please let me know if I can file a consent motion for a 1-day extension.

Sincerely,  
Mike

Mike Matesky  
Matesky Law PLLC  
4500 9<sup>th</sup> Ave. NE, Suite 300  
Seattle, WA 98105  
**(Please Note New Street/Mailing Address Above)**  
Ph: 206.701.0331  
Fax: 206.701.0332  
[mike@mateskylaw.com](mailto:mike@mateskylaw.com)  
[www.mateskylaw.com](http://www.mateskylaw.com)





# MATESKY LAW PLLC

Business | Intellectual Property | Technology | Entertainment

This message and any attachments may contain PRIVILEGED and CONFIDENTIAL material intended solely for the indicated recipient. If you believe you have received this e-mail in error, please advise the sender, permanently delete the message and all attachments, and refrain from copying, using, or disclosing the contents. Thank you.

---

**From:** Mike Matesky

**Sent:** Tuesday, December 08, 2020 8:29 PM

**To:** 'Nancy Stephens' <[nancy.stephens@foster.com](mailto:nancy.stephens@foster.com)>; 'Ben Hodges' <[ben.hodges@foster.com](mailto:ben.hodges@foster.com)>; 'Kelly Mennemeier' <[kelly.mennemeier@foster.com](mailto:kelly.mennemeier@foster.com)>

**Cc:** 'Michael Galletch' <[mike@psbizlit.com](mailto:mike@psbizlit.com)>

**Subject:** Reply in Support of Motion to Strike/Extend

Dear Counsel,

Attached please find Applicant's Reply in Support of Motion to Order Service of Testimony Depositions, Strike Opposer's Notice of Reliance, and Extend Applicant's Trial Period, as well as my reply declaration in support thereof.

I have been trying to file this through ESTTA this evening, but I am unable to do so. I am receiving an error message stating "Database used by ESTTA is not available at this time. Please try again later." (Interestingly, opposing counsel in another matter of mine had this same problem on Friday, but somehow was able to get a document filed yesterday).

I will continue to try to get this filed, but would appreciate your stipulation/consent to extend the filing deadline retroactively if I cannot get it filed in the next half hour or so.

Sincerely,  
Mike

Mike Matesky  
Matesky Law PLLC  
4500 9<sup>th</sup> Ave. NE, Suite 300  
Seattle, WA 98105  
**(Please Note New Street/Mailing Address Above)**  
Ph: 206.701.0331  
Fax: 206.701.0332  
[mike@mateskylaw.com](mailto:mike@mateskylaw.com)  
[www.mateskylaw.com](http://www.mateskylaw.com)



**MATESKY LAW** PLLC

Business | Intellectual Property | Technology | Entertainment

This message and any attachments may contain PRIVILEGED and CONFIDENTIAL material intended solely for the indicated recipient. If you believe you have received this e-mail in error, please advise the sender, permanently delete the message and all attachments, and refrain from copying, using, or disclosing the contents. Thank you.

# EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE  
MINISTRIES,

Opposer,

v.

UNIVERSAL LIFE CHURCH  
MONASTERY STOREHOUSE,

Applicant.

Opposition No. 91237315

SUBSTITUTE REPLY IN SUPPORT OF  
MOTION TO ORDER SERVICE OF  
TESTIMONY DEPOSITIONS, STRIKE  
OPPOSER'S NOTICE OF RELIANCE,  
AND EXTEND APPLICANT'S TRIAL  
PERIOD

## **I. INTRODUCTION**

Although the parties have resolved several issues raised in Applicant's motion, Opposer has refused to cure many of the deficiencies raised therein. First, Opposer has failed to cite any law or evidence supporting its claim that Exhibits I-K to Opposer's Notice of Reliance are admissible. Accordingly, the Board should strike or disregard Exhibits I-K. Second, Applicant objected to the statements of relevance in Opposer's Notice of Reliance with ample time left for Opposer to cure, but Opposer simply chose not to do so. Accordingly, the Board should strike Opposer's Notice of Reliance. Third, although the parties have stipulated to extend Applicant's trial period, Opposer refuses to agree that Applicant should be allowed any period in which to submit evidence in direct response to any supplemental submission from Opposer. Accordingly, if the Board grants Opposer the opportunity to make any supplemental submission, the Board should also allow Applicant a brief trial period in which to address any new issues raised by such a supplemental submission.

## **II. RELEVANT BACKGROUND**

Applicant sets forth the following factual and procedural background herein to address the allegations in Opposer's response brief.

### **A. Applicant Raised Objections as Promptly as Possible**

Pursuant to the parties' stipulation, Opposer's testimony period closed on September 11, 2020. 38 TTABVUE 2. The undersigned counsel was out of the office the following week, and had previously informed Opposer of that fact. The undersigned counsel is a solo practitioner, and his firm does not employ any other attorneys. In keeping with public health guidelines, the undersigned counsel has worked from his home during the 2020 COVID-19 pandemic. The undersigned counsel

is also the father of two elementary-school students that attend Seattle Public Schools, and is married to a pre-school teacher. Declaration of Michael P. Matesky, II submitted herewith (“Matesky Reply Decl.”) ¶¶ 4-7.

In September 2020, Seattle Public Schools began a robust, fully-online class schedule, which continues through the present. This schedule requires the same number of school hours as in the traditional, in-person format, but with students working exclusively from home. This, not surprisingly, has required a great deal of parental support, especially as students began this program in September and October. This, also not surprisingly, resulted in significant technical difficulties on the part of students, teachers, and the school district. Such mishaps could not be fixed by elementary school students, but required regular adult intervention, as all parties attempted to figure out how to work successfully within the new online-only paradigm. At the same time, the undersigned counsel’s wife began to conduct an online-school program from the same household, for a school that does not have any IT personnel. *Id.* ¶¶ 8-11.

Essentially, during September and the first part of October 2020, the undersigned counsel became the *ad hoc* educational coordinator and IT “professional” responsible for fixing regular technical difficulties faced by two elementary students and a teacher attempting to make online learning work from the same household in which the undersigned counsel was operating his solo law practice. This unexpected burden imposed by the COVID-19 pandemic, combined with the undersigned counsel’s general workload as a solo practitioner and previously-scheduled week out of office immediately following submission of Opposer’s Notice of Reliance, made it extremely difficult to address all of the failures of Opposer’s evidentiary submissions in a speedy fashion. *Id.* ¶¶ 12-13.

This difficulty in speedily raising Opposer's evidentiary deficiencies was exacerbated by the variety and number of such deficiencies, and the fact that Opposer itself did not file or serve documents in a timely fashion. *Id.* ¶¶ 13-16; Matesky Decl. ¶¶ 9-11, 13, 46 TTABVUE 15-16. Opposer does not dispute that it failed to file multiple exhibits until after its testimony period closed on September 11<sup>th</sup>. Rather, Opposer filed several exhibits on September 25<sup>th</sup>—fourteen days after the close of its trial period. Opp. at 3-4, 56 TTABVUE 4-5; 44 TTABVUE 1-194; 45 TTABVUE 1. Despite learning by September 14<sup>th</sup> that it had not served Exhibit I on Applicant, Opposer did not get around to serving Exhibit I on Applicant until November 17<sup>th</sup>—after Applicant filed its motion. Matesky Decl. ¶¶ 10-11, 46 TTABVUE 16; Matesky Reply Decl. ¶ 14. Opposer also does not dispute that it failed to serve copies of the Dylan Wall, Glenn Yoshioka, and Lewis King deposition transcripts, and exhibits thereto, until November 2, 2020. Opp. at 3, 56 TTABVUE 4; Matesky Reply Decl. ¶ 15. This was 28 days after Opposer's October 4, 2020 deadline to serve the Wall deposition, and 21 days after Opposer's October 11, 2020 deadline to serve the Yoshioka and King depositions. *See* Matesky Declaration ¶¶ 4, 6-7, 46 TTABVUE 15; 37 CFR § 2.125(b). Thus, rather than filing multiple piecemeal motions regarding Opposer's multiple and varied evidentiary deficiencies, Applicant filed a single motion addressing all such deficiencies on October 29, 2020. 46 TTABVUE 1-40; Matesky Reply Decl. ¶ 16.

**B. The Parties Have Narrowed the Scope of Dispute**

Applicant filed its motion in an attempt to avoid any further delay in resolving outstanding evidentiary issues, as it appeared unlikely the parties could resolve all outstanding issues by stipulation. Matesky Reply Decl. ¶ 16. However, Applicant informed Opposer immediately upon filing that it would like to discuss the issues raised in its motion, to see if any such issues could be

resolved by stipulation and stricken from the motion. *Id.* ¶ 17. Although Opposer did not initially respond, the parties were eventually able to narrow the scope of dispute by stipulation. *Id.* ¶ 18.

Applicant agreed to withdraw the objections to Opposer's Notice of Reliance Exhibits B and C stated in Applicant's motion (without waiving other potential objections, such as hearsay). The parties also initially agreed to extend Applicant's trial period by 28-days, without prejudice to Applicant's pending request it be allowed some testimony period to submit evidence after Opposer submits any supplemental Notice of Reliance. *See id.*; 53 TTABVUE 2. The parties subsequently stipulated that Applicant's testimony period would close on December 15, 2020, subject to the same terms. *See* 57 TTABVUE 2; Matesky Reply Decl. ¶ 18. Opposer no longer relies on Exhibits U-Z to its notice of Reliance. Opp. at 8, 56 TTABVUE 9.

**C. Three Disputed Issues Remain**

Although the parties have resolved some issues, four disputed issues remain. First, the parties disagree regarding the inadmissibility of Exhibits I-K to Opposer's Notice of Reliance. Second, the parties disagree regarding the inadequacy of the statements of relevance in Opposer's Notice of Reliance. Third, the parties disagree whether Applicant should have any period to submit evidence in strict response to any supplemental or amended evidentiary submissions from Opposer.

**III. ARGUMENT**

**A. Exhibits I-K to Opposer's Notice of Reliance are Inadmissible**

The Board should strike or disregard Exhibits I-K to Opposer's Notice of Reliance because (1) briefs and declarations cannot be introduced via a Notice of Reliance, and (2) the declarations of Nancy Stephens and Dylan Wall are inadmissible due to Opposer's failure to disclose such



testimony and the Board's prior ruling excluding such evidence. Opposer has filed to cite any law, or any evidence, rebutting the arguments set forth in Applicant's motion regarding the inadmissibility of Exhibits I-K to Opposer's Notice of Reliance. Accordingly, the Board should strike or disregard Exhibits I-K.

1. Briefs and Declarations May Not be Admitted by Notice of Reliance

Exhibits I-K to Opposer's Notice of Reliance consist of Opposer's summary judgment briefs and the declarations of Nancy Stephens<sup>1</sup> and Dylan Wall (and exhibits thereto) filed in support of such briefs. *See* Not. of Reliance Ex. I, 41 TTABVUE 1; Not. of Reliance Ex. J, 43 TTABVUE 233-46; Not. of Reliance Ex. K, 43 TTABVUE 234-399. These are not documents that may be admitted into evidence via a Notice of Reliance. *See* 37 CFR §§ 2.120(k), 2.122(g); App. Mot. at 8-9, 46 TTABVUE 9-10. Opposer does not contest this in its opposition. First, with regard to its summary judgment briefs, Opposer concedes that they "are not evidence" and that it "does not intend to rely" on them. Opp. at 7, 56 TTABVUE 8. Second, Opposer cites no authority whatsoever suggesting that briefs or declarations may be entered into evidence via a Notice of Reliance. *See id.* at 7-8, 56 TTABVUE 8-9.

Rather, Opposer claims it submitted Exhibits I-K "per Trademark Rule 2.122(c)." *Id.* at 7, 56 TTABVUE 8. Yet, Rule 2.122(c) does not authorize introduction of briefs, declarations, or exhibits thereto via a Notice of Reliance. Rule 2.122(g) explicitly limits the types of documents admissible via a Notice of Reliance to those identified in "in paragraphs (d)(2) and (e)(1) and (2) of

---

<sup>1</sup> Applicant cannot cite to the specific pages comprising the Stephens declaration on TTABVUE because it was filed under seal. Applicant could not cite to the specific pages comprising the Stephens declaration in its opening motion because Opposer did not serve a copy of Exhibit I (as described in its Notice of Reliance and purportedly as filed with the Board under seal), until after Applicant filed its motion. Matesky Reply Decl. ¶ 14. However, the pages of Exhibit I (as belatedly served on Applicant) comprising the Stephens declaration and exhibits

this section and § 2.120(k).” It does not permit admission of documents identified in paragraph 2.122(c).<sup>2</sup> Thus, Opposer has failed to properly introduce exhibits I-K into evidence, and the Board should strike or disregard these exhibits.

2. Declarations of Nancy Stephens and Dylan Wall are Inadmissible for Lack of Disclosure and the Board’s Previously-Identified Deficiencies

The Board should also strike or disregard the declarations of Dylan Wall and Nancy Stephens due to OPPOSER’s failure to disclose such testimony and Board’s prior order excluding such evidence. As argued in Applicant’s motion, “Ms. Stephens was not identified as a witness in Opposer’s pre-trial disclosures, and Opposer stated that Mr. Wall would be providing trial testimony by oral deposition, not by testimony declaration.” App’s Mot. at 9, 46 TTABVUE 10. Applicant also argued that “the Board has already stricken or disregarded much of the testimony and the exhibits attached to the Stephens and Wall declarations in its prior order denying Opposer’s Motion for Partial Summary Judgment.” *Id.* at 9-10, 46 TTABVUE 10-11. Opposer does not rebut either of these grounds for exclusion.

First, Opposer pretends as if the Nancy Stephens declaration does not exist, claiming that Exhibits I-K consist solely of Opposer’s briefs and the Wall declaration. *See* Opp. at 7 (acknowledging only the Wall declaration, without mentioning the Stephens declaration); 56 TTABVUE 8. Second, Opposer claims that Applicant “fails to put forth argument as to why this evidence should be excluded.” *Id.* As discussed in the preceding paragraph, a simple read of pages

---

thereto are Bates labeled as AMM NOR 1083 – 1170.

2 Rule 2.122(c) states “[e]xcept as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.” Thus, it is possible that Opposer might have introduced Exhibits I-K via one of the testimony depositions it conducted, but not by a Notice of Reliance.

9 and 10 of Applicant's motion shows this is not true. *See* 46 TTABVUE 10-11. Opposer does not claim that it did adequately disclose the Wall and Stephens declaration testimony in its pretrial disclosures, nor does it argue that it is allowed to introduce such undisclosed witness testimony. *See* Opp. at 7-8; 56 TTABVUE 8-9. Opposer has simply failed to provide any rationale or justification for its failure to adequately disclose the declaration testimony from Ms. Stephens and Mr. Wall that Opposer submitted at the close of its testimony period.

Moreover, with regard to the portions of the Stephens and Wall declarations that the Board has already held to be inadmissible, Opposer now claims that the Board should "reconsider" such evidence, Opp. at 7, and that "Opposer cured a number of Applicant's previous evidentiary objections through the testimony elicited at the recent deposition," Opp. at 8 n.2, 56 TTABVUE 9. Yet, Opposer does not cite any Board rule or legal authority justifying a motion reconsideration (which Opposer has not field). *Id.* Similarly, although it claims that it has now "cured" the evidentiary deficiencies that the led the Board to exclude such evidence, it does not cite any law or evidence in support of that claim. *Id.*

Opposer argues that, because Applicant did not re-type all the arguments previously submitted to and decided by the Board regarding the inadmissibility of this evidence, Opposer had no "opportunity" to show that it has cured these previously-adjudicated deficiencies. *Id.* This is a hard argument to swallow. The Board's rationale for excluding such evidence was clearly laid out in its order denying Opposer's summary judgment motion. 36 TTABVUE 6-7. If Opposer truly had "cured" the deficiencies identified by the Board, it could have supported that claim with citations to law and evidence. It did not do so.

Thus, because Opposer utterly fails to respond to the evidentiary deficiencies laid out in Applicant's motion, the Board should strike or disregard the Stephens and Wall declarations contained in Exhibits I-K.

**B. The Board Should Strike OPPOSER's Notice of Reliance**

The Board should strike Opposer's Notice of Reliance because Opposer fails to adequately identify the relevance of materials submitted therewith to disputed issues and claims in this proceeding, and Opposer is not prejudiced by any alleged delay in raising objections. Opposer argues that Applicant has waived this objection by failing to timely raise it, relying on *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 U.S.P.Q.2d 1844 (T.T.A.B. 2017). However, *Apollo* is distinguishable from this case in numerous respects. First, the applicant in *Apollo* waited to file its evidentiary objection simultaneously with its brief on the case, after all testimony periods were closed. *See* Applicant's Separate Statement of Evidentiary Objections, Opp. No. 91219435 at \*4, 14 TTABVUE 6; *see also* Trial Brief of Applicant Medical Extrusion Technologies, Inc., Opp. No. 91219435, 16 TTABVUE 1-16 (filed the same day). In contrast, Applicant raised its objection on October 29<sup>th</sup>—before the original close of its testimony period, forty-seven days before the stipulated December 15<sup>th</sup> close of its testimony period, and long before submission of any briefs on the case. *See* 46 TTABVUE 6-8 (Applicant's motion filed October 29<sup>th</sup>); 53 TTABVUE 2 (November 9th stipulation extending trial period to December 7<sup>th</sup>); 57 TTABVUE 2 (December 4<sup>th</sup> stipulation extending trial period to December 15<sup>th</sup>).

Moreover, *Apollo* and the sources cited therein hold only that a party "risks" waiving an objection to the statements of relevance in a notice of reliance if it raises the objection after its testimony period starts. 123 U.S.P.Q.2d at 1846-47. Such waiver is not automatic, and a finding of

waiver is not warranted in this case. First, as stated above, Applicant's inability to raise this objection before start of its testimony period was due to extraordinary circumstances presented by the COVID-19 pandemic, the multiple and varied deficiencies in the evidence presented by Opposer, and a desire to raise all such deficiencies in an efficient single motion—not lack of diligence or any attempt to spring an objection on Opposer after it could no longer cure the deficiency. *Supra* Section II(A).

Second, the rationale of *Apollo* is that defects in a party's statements of relevance are curable, and it would be inequitable to allow an objection to be raised simultaneously with a brief on the case, when there is no longer any opportunity to cure the deficiency. *See* 123 U.S.P.Q.2d at 1846-47. Yet, given the circumstances, Applicant raised this objection with ample time left for Opposer to cure its defect; Opposer has simply chosen not to do so. The parties first stipulated that Applicant's testimony period would terminate on December 7<sup>th</sup> (based on Opposer's admitted failure to serve deposition transcripts), then stipulated that it would end on December 15<sup>th</sup> (in order to accommodate both parties' schedules). Matesky Reply Decl. ¶¶ 18-19; 53 TTABVUE 2; 57 TTABVUE 2. This means that Applicant raised its objection to the statements of relevance in Opposer's Notice of Reliance forty-seven days before the close of Applicant's testimony period. Opposer could have easily cured its defective Notice of Reliance without affecting the parties' schedule at all. It has simply chosen not to do so.

Thus, because Opposer's Notice of Reliance fails to adequately identify the relevance of the evidence submitted therewith, and because Opposer has refused to cure this deficiency despite ample time to do so, the Board should strike Opposer's Notice of Reliance.

**C. The Board Should Allow Applicant to Submit Evidence in**

### **Strict Response to any Amended or Supplemental Notice of Reliance**

Because Opposer has refused to cure the deficiencies in its Notice of Reliance despite ample time to do so, it does not require leave to file any supplemental notice or evidentiary submission. However, if the Board were to allow Opposer to submit any supplemental Notice of Reliance, it should allow Applicant a supplemental testimony period to submit evidence strictly responding to any new issues raised by such supplemental submission. Opposer argues that Applicant's request for a 60-day extension of its trial period following a Board order on Applicant's motion is excessive, because Opposer served deposition transcripts between 21 and 28 days late. Opp. at 9-10; 56 TTABVUE 10-11. However, when Applicant proposed a lesser extension, Opposer refused to agree to any additional evidentiary period to address new issues raised by any supplemental submission from Opposer. Matesky Reply Decl. ¶ 19. It appears that Opposer's true aim to prevent Applicant from rebutting any new issues raised by a supplemental submission. To the extent the Board authorizes any supplemental submission from Opposer, Applicant requests that it be allowed some period to submit evidence in strict response to new issues raised by such supplemental submission.

### **IV. CONCLUSION**

For the reasons set forth above, Applicant requests that the Board **(1)** strike or disregard Exhibits I-K to OPPOSER's Notice of Reliance, **(2)** strike Opposer's Notice of Reliance, **(3)** order Opposer to file and serve properly labeled exhibits to the Goschie and King depositions, and **(4)** in the event the Board allows any amended or supplemental submission from Opposer, allow Applicant a supplemental testimony period to submit evidence in strict response to any new issues raised by such supplemental submission.

DATED: December 30, 2020

Respectfully submitted:

MATESKY LAW<sup>PLLC</sup>

s/ Michael P. Matesky, II/

Michael P. Matesky, II  
(Washington Bar No. 39586)  
4500 9<sup>th</sup> Ave. NE, Suite 300  
Seattle, WA 98105  
Ph: 206.701.0331  
Fax: 206.702.0332  
Email: [mike@mateskylaw.com](mailto:mike@mateskylaw.com);  
[litigation@mateskylaw.com](mailto:litigation@mateskylaw.com)

Attorney for Applicant

# EXHIBIT C



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

AMERICAN MARRIAGE  
MINISTRIES,

Opposer,

v.

UNIVERSAL LIFE CHURCH  
MONASTERY STOREHOUSE,

Applicant.

Opposition No. 91237315

SUBSTITUTE REPLY IN SUPPORT OF  
MOTION TO ORDER SERVICE OF  
TESTIMONY DEPOSITIONS, STRIKE  
OPPOSER’S NOTICE OF RELIANCE,  
AND EXTEND APPLICANT’S TRIAL  
PERIOD

Formatted

## **I. INTRODUCTION**

Although the parties have resolved several issues raised in Applicant's motion, Opposer has refused to cure many of the deficiencies raised therein. First, Opposer has failed to cite any law or evidence supporting its claim that Exhibits I-K to Opposer's Notice of Reliance are admissible. Accordingly, the Board should strike or disregard Exhibits I-K. Second, Applicant objected to the statements of relevance in Opposer's Notice of Reliance with ample time left for Opposer to cure, but Opposer simply chose not to do so. Accordingly, the Board should strike Opposer's Notice of Reliance. Third, ~~although Opposer has now belatedly served copies of testimony depositions and exhibits, exhibits to the Dallas Goschie and Lewis King depositions are unlabeled. Accordingly, the Board should order Opposer to file and serve properly labeled copies of such exhibits. Fourth,~~ although the parties have stipulated to extend Applicant's trial period, Opposer refuses to agree that Applicant should be allowed any period in which to submit evidence in direct response to any supplemental submission from Opposer. Accordingly, if the Board grants Opposer the opportunity to make any supplemental submission, the Board should also allow Applicant a brief trial period in which to address any new issues raised by such a supplemental submission.

## **II. RELEVANT BACKGROUND**

Applicant sets forth the following factual and procedural background herein to address ~~(A)~~ the allegations in Opposer's response brief, ~~and (B) developments that have occurred since filing of Applicant's opening brief.~~

### **A. Applicant Raised Objections as Promptly as Possible**

Pursuant to the parties' stipulation, Opposer's testimony period closed on September 11, 2020. 38 TTABVUE 2. The undersigned counsel was out of the office the following week, and had previously informed Opposer of that fact. The undersigned counsel is a solo practitioner, and his firm does not employ any other attorneys. In keeping with public health guidelines, the undersigned counsel has worked from his home during the 2020 COVID-19 pandemic. The undersigned counsel is also the father of two elementary-school students that attend Seattle Public Schools, and is married to a pre-school teacher. Declaration of Michael P. Matesky, II submitted herewith ("Matesky Reply Decl.") ¶¶ 4-7.

In September 2020, Seattle Public Schools began a robust, fully-online class schedule, which continues through the present. This schedule requires the same number of school hours as in the traditional, in-person format, but with students working exclusively from home. This, not surprisingly, has required a great deal of parental support, especially as students began this program in September and October. This, also not surprisingly, resulted in significant technical difficulties on the part of students, teachers, and the school district. Such mishaps could not be fixed by elementary school students, but required regular adult intervention, as all parties attempted to figure out how to work successfully within the new online-only paradigm. At the same time, the undersigned counsel's wife began to conduct an online-school program from the same household, for a school that does not have any IT personnel. *Id.* ¶¶ 8-11.

Essentially, during September and the first part of October 2020, the undersigned counsel became the *ad hoc* educational coordinator and IT "professional" responsible for fixing regular technical difficulties faced by two elementary students and a teacher attempting to make online learning work from the same household in which the undersigned counsel was operating his solo law

practice. This unexpected burden imposed by the COVID-19 pandemic, combined with the undersigned counsel's general workload as a solo practitioner and previously-scheduled week out of office immediately following submission of Opposer's Notice of Reliance, made it extremely difficult to address all of the failures of Opposer's evidentiary submissions in a speedy fashion. *Id.* ¶¶ 12-13.

This difficulty in speedily raising Opposer's evidentiary deficiencies was exacerbated by the variety and number of such deficiencies, and the fact that Opposer itself did not file or serve documents in a timely fashion. *Id.* ¶¶ 13-16; Matesky Decl. ¶¶ 9-11, 13, 46 TTABVUE 15-16. Opposer does not dispute that it failed to file multiple exhibits until after its testimony period closed on September 11<sup>th</sup>. Rather, Opposer filed several exhibits on September 25<sup>th</sup>—fourteen days after the close of its trial period. *Opp.* at 3-4, 56 TTABVUE 4-5; 44 TTABVUE 1-194; 45 TTABVUE 1. Despite learning by September 14<sup>th</sup> that it had not served Exhibit I on Applicant, Opposer did not get around to serving Exhibit I on Applicant until November 17<sup>th</sup>—after Applicant filed its motion. Matesky Decl. ¶¶ 10-11, 46 TTABVUE 16; Matesky Reply Decl. ¶ 14. Opposer also does not dispute that it failed to serve copies of the Dylan Wall, Glenn Yoshioka, and Lewis King deposition transcripts, and exhibits thereto, until November 2, 2020. *Opp.* at 3, 56 TTABVUE 4; Matesky Reply Decl. ¶ 15. This was 28 days after Opposer's October 4, 2020 deadline to serve the Wall deposition, and 21 days after Opposer's October 11, 2020 deadline to serve the Yoshioka and King depositions. *See* Matesky Declaration ¶¶ 4, 6-7, 46 TTABVUE 15; 37 CFR § 2.125(b). Thus, rather than filing multiple piecemeal motions regarding Opposer's multiple and varied evidentiary deficiencies, Applicant filed a single motion addressing all such deficiencies on October 29, 2020. 46 TTABVUE 1-40; Matesky Reply Decl. ¶ 16.

**B. The Parties Have Narrowed the Scope of Dispute**

Applicant filed its motion in an attempt to avoid any further delay in resolving outstanding evidentiary issues, as it appeared unlikely the parties could resolve all outstanding issues by stipulation. Matesky Reply Decl. ¶ 16. However, Applicant informed Opposer immediately upon filing that it would like to discuss the issues raised in its motion, to see if any such issues could be resolved by stipulation and stricken from the motion. *Id.* ¶ 17. Although Opposer did not initially respond, the parties were eventually able to narrow the scope of dispute by stipulation. *Id.* ¶ 18.

Applicant agreed to withdraw the objections to Opposer's Notice of Reliance Exhibits B and C stated in Applicant's motion (without waiving other potential objections, such as hearsay). The parties also initially agreed to extend Applicant's trial period by 28-days, without prejudice to Applicant's pending request it be allowed some testimony period to submit evidence after Opposer submits any supplemental Notice of Reliance. *See id.*; 53 TTABVUE 2. The parties subsequently stipulated that Applicant's testimony period would close on December 15, 2020, subject to the same terms. *See* 57 TTABVUE 2; Matesky Reply Decl. ¶ 18.

Opposer no longer relies on Exhibits U-Z to its notice of Reliance. Opp. at 8, 56 TTABVUE 9. ~~Rather, OPPOSER has now filed and served deposition transcripts and exhibits for the Wall, Yoshioka, King, Freeman, Goshie, and Wozeniak depositions. 47-52, 54-55 TTABVUE. However, the exhibits to the Goshie deposition are not labeled. 54 TTABVUE 83-117. Similarly, only one of the three exhibits to the King deposition is labeled. Compare 55 TTABVUE 7, with 55 TTABVUE 132-35.~~

**C. Four-Three Disputed Issues Remain**

Although the parties have resolved some issues, four disputed issues remain. First, the parties disagree regarding the inadmissibility of Exhibits I-K to Opposer's Notice of Reliance. Second, the parties disagree regarding the inadequacy of the statements of relevance in Opposer's Notice of Reliance. Third, ~~Opposer has not filed or served labeled exhibits for the Gosehie or King depositions.~~ Fourth, the parties disagree whether Applicant should have any period to submit evidence in strict response to any supplemental or amended evidentiary submissions from Opposer.

### **III. ARGUMENT**

#### **A. Exhibits I-K to Opposer's Notice of Reliance are Inadmissible**

The Board should strike or disregard Exhibits I-K to Opposer's Notice of Reliance because (1) briefs and declarations cannot be introduced via a Notice of Reliance, and (2) the declarations of Nancy Stephens and Dylan Wall are inadmissible due to Opposer's failure to disclose such testimony and the Board's prior ruling excluding such evidence. Opposer has filed to cite any law, or any evidence, rebutting the arguments set forth in Applicant's motion regarding the inadmissibility of Exhibits I-K to Opposer's Notice of Reliance. Accordingly, the Board should strike or disregard Exhibits I-K.

##### **1. Briefs and Declarations May Not be Admitted by Notice of Reliance**

Exhibits I-K to Opposer's Notice of Reliance consist of Opposer's summary judgment briefs and the declarations of Nancy Stephens<sup>1</sup> and Dylan Wall (and exhibits thereto) filed in support of such briefs. *See* Not. of Reliance Ex. I, 41 TTABVUE 1; Not. of Reliance Ex. J, 43 TTABVUE

---

<sup>1</sup> Applicant cannot cite to the specific pages comprising the Stephens declaration on TTABVUE because it was filed under seal. Applicant could not cite to the specific pages comprising the Stephens declaration in its opening motion because Opposer did not serve a copy of Exhibit I (as described in its Notice of Reliance and purportedly as filed with the Board under seal), until after Applicant filed its motion. Matesky Reply Decl. ¶ 14. However, the pages of Exhibit I (as belatedly served on Applicant) comprising the Stephens declaration and exhibits

233-46; Not. of Reliance Ex. K, 43 TTABVUE 234-399. These are not documents that may be admitted into evidence via a Notice of Reliance. *See* 37 CFR §§ 2.120(k), 2.122(g); App. Mot. at 8-9, 46 TTABVUE 9-10. Opposer does not contest this in its opposition. First, with regard to its summary judgment briefs, Opposer concedes that they “are not evidence” and that it “does not intend to rely” on them. Opp. at 7, 56 TTABVUE 8. Second, Opposer cites no authority whatsoever suggesting that briefs or declarations may be entered into evidence via a Notice of Reliance. *See id.* at 7-8, 56 TTABVUE 8-9.

Rather, Opposer claims it submitted Exhibits I-K “per Trademark Rule 2.122(c).” *Id.* at 7, 56 TTABVUE 8. Yet, Rule 2.122(c) does not authorize introduction of briefs, declarations, or exhibits thereto via a Notice of Reliance. Rule 2.122(g) explicitly limits the types of documents admissible via a Notice of Reliance to those identified in “in paragraphs (d)(2) and (e)(1) and (2) of this section and § 2.120(k).” It does not permit admission of documents identified in paragraph 2.122(c).<sup>2</sup> Thus, Opposer has failed to properly introduce exhibits I-K into evidence, and the Board should strike or disregard these exhibits.

2. Declarations of Nancy Stephens and Dylan Wall are Inadmissible for Lack of Disclosure and the Board’s Previously-Identified Deficiencies

The Board should also strike or disregard the declarations of Dylan Wall and Nancy Stephens due to OPPOSER’s failure to disclose such testimony and Board’s prior order excluding such evidence. As argued in Applicant’s motion, “Ms. Stephens was not identified as a witness in

---

thereto are Bates labeled as AMM NOR 1083 – 1170.

<sup>2</sup> Rule 2.122(c) states “[e]xcept as provided in paragraph (d)(1) of this section, an exhibit attached to a pleading is not evidence on behalf of the party to whose pleading the exhibit is attached, and must be identified and introduced in evidence as an exhibit during the period for the taking of testimony.” Thus, it is possible that Opposer might have introduced Exhibits I-K via one of the testimony depositions it conducted, but not by a Notice of Reliance.

Opposer's pre-trial disclosures, and Opposer stated that Mr. Wall would be providing trial testimony by oral deposition, not by testimony declaration." App's Mot. at 9, 46 TTABVUE 10. Applicant also argued that "the Board has already stricken or disregarded much of the testimony and the exhibits attached to the Stephens and Wall declarations in its prior order denying Opposer's Motion for Partial Summary Judgment." *Id.* at 9-10, 46 TTABVUE 10-11. Opposer does not rebut either of these grounds for exclusion.

First, Opposer pretends as if the Nancy Stephens declaration does not exist, claiming that Exhibits I-K consist solely of Opposer's briefs and the Wall declaration. *See* Opp. at 7 (acknowledging only the Wall declaration, without mentioning the Stephens declaration); 56 TTABVUE 8. Second, Opposer claims that Applicant "fails to put forth argument as to why this evidence should be excluded." *Id.* As discussed in the preceding paragraph, a simple read of pages 9 and 10 of Applicant's motion shows this is not true. *See* 46 TTABVUE 10-11. Opposer does not claim that it did adequately disclose the Wall and Stephens declaration testimony in its pretrial disclosures, nor does it argue that it is allowed to introduce such undisclosed witness testimony. *See* Opp. at 7-8; 56 TTABVUE 8-9. Opposer has simply failed to provide any rationale or justification for its failure to adequately disclose the declaration testimony from Ms. Stephens and Mr. Wall that Opposer submitted at the close of its testimony period.

Moreover, with regard to the portions of the Stephens and Wall declarations that the Board has already held to be inadmissible, Opposer now claims that the Board should "reconsider" such evidence, Opp. at 7, and that "Opposer cured a number of Applicant's previous evidentiary objections through the testimony elicited at the recent deposition," Opp. at 8 n.2, 56 TTABVUE 9. Yet, Opposer does not cite any Board rule or legal authority justifying a motion reconsideration



(which Opposer has not field). *Id.* Similarly, although it claims that it has now “cured” the evidentiary deficiencies that the led the Board to exclude such evidence, it does not cite any law or evidence in support of that claim. *Id.*

Opposer argues that, because Applicant did not re-type all the arguments previously submitted to and decided by the Board regarding the inadmissibility of this evidence, Opposer had no “opportunity” to show that it has cured these previously-adjudicated deficiencies. *Id.* This is a hard argument to swallow. The Board’s rationale for excluding such evidence was clearly laid out in its order denying Opposer’s summary judgment motion. 36 TTABVUE 6-7. If Opposer truly had “cured” the deficiencies identified by the Board, it could have supported that claim with citations to law and evidence. It did not do so.

Thus, because Opposer utterly fails to respond to the evidentiary deficiencies laid out in Applicant’s motion, the Board should strike or disregard the Stephens and Wall declarations contained in Exhibits I-K.

**B. The Board Should Strike OPPOSER’s Notice of Reliance**

The Board should strike Opposer’s Notice of Reliance because Opposer fails to adequately identify the relevance of materials submitted therewith to disputed issues and claims in this proceeding, and Opposer is not prejudiced by any alleged delay in raising objections. Opposer argues that Applicant has waived this objection by failing to timely raise it, relying on *Apollo Med. Extrusion Techs., Inc. v. Med. Extrusion Techs., Inc.*, 123 U.S.P.Q.2d 1844 (T.T.A.B. 2017). However, *Apollo* is distinguishable from this case in numerous respects. First, the applicant in *Apollo* waited to file its evidentiary objection simultaneously with its brief on the case, after all testimony periods were closed. *See* Applicant’s Separate Statement of Evidentiary Objections, Opp.

No. 91219435 at \*4, 14 TTABVUE 6; *see also* Trial Brief of Applicant Medical Extrusion Technologies, Inc., Opp. No. 91219435, 16 TTABVUE 1-16 (filed the same day). In contrast, Applicant raised its objection on October 29<sup>th</sup>—before the original close of its testimony period, forty-seven days before the stipulated December 15<sup>th</sup> close of its testimony period, and long before submission of any briefs on the case. *See* 46 TTABVUE 6-8 (Applicant’s motion filed October 29<sup>th</sup>); 53 TTABVUE 2 (November 9<sup>th</sup> stipulation extending trial period to December 7<sup>th</sup>); 57 TTABVUE 2 (December 4<sup>th</sup> stipulation extending trial period to December 15<sup>th</sup>).

Moreover, *Apollo* and the sources cited therein hold only that a party “risks” waiving an objection to the statements of relevance in a notice of reliance if it raises the objection after its testimony period starts. 123 U.S.P.Q.2d at 1846-47. Such waiver is not automatic, and a finding of waiver is not warranted in this case. First, as stated above, Applicant’s inability to raise this objection before start of its testimony period was due to extraordinary circumstances presented by the COVID-19 pandemic, the multiple and varied deficiencies in the evidence presented by Opposer, and a desire to raise all such deficiencies in an efficient single motion—not lack of diligence or any attempt to spring an objection on Opposer after it could no longer cure the deficiency. *Supra* Section II(A).

Second, the rationale of *Apollo* is that defects in a party’s statements of relevance are curable, and it would be inequitable to allow an objection to be raised simultaneously with a brief on the case, when there is no longer any opportunity to cure the deficiency. *See* 123 U.S.P.Q.2d at 1846-47. Yet, given the circumstances, Applicant raised this objection with ample time left for Opposer to cure its defect; Opposer has simply chosen not to do so. The parties first stipulated that Applicant’s testimony period would terminate on December 7<sup>th</sup> (based on Opposer’s admitted failure

to serve deposition transcripts), then stipulated that it would end on December 15<sup>th</sup> (in order to accommodate both parties' schedules). Matesky Reply Decl. ¶¶ 18-19; 53 TTABVUE 2; 57 TTABVUE 2. This means that Applicant raised its objection to the statements of relevance in Opposer's Notice of Reliance forty-seven days before the close of Applicant's testimony period. Opposer could have easily cured its defective Notice of Reliance without affecting the parties' schedule at all. It has simply chosen not to do so.

Thus, because Opposer's Notice of Reliance fails to adequately identify the relevance of the evidence submitted therewith, and because Opposer has refused to cure this deficiency despite ample time to do so, the Board should strike Opposer's Notice of Reliance.

**C. ~~Opposer Has Not Filed or Served Properly Labelled Exhibits~~**

~~The Board should order Opposer to file and serve on Applicant copies of the transcripts and exhibits from the Goshie and King depositions that comply with Board rules. A party that conducts a testimony deposition must file such deposition with the Board. 37 CFR § 2.123(h). In doing so, the exhibits "must be numbered or lettered consecutively and each must be marked with the number and title of the case and the name of the party offering the exhibit." 37 CFR § 2.123(g)(2). The exhibits to the Goshie deposition are not marked at all. See 54 TTABVUE 83-117. Only one exhibit to the King deposition (Exhibit 47) is marked. There are no labels distinguishing Exhibits 48 or 49 from Exhibit 47. Compare 55 TTABVUE 7, with 55 TTABVUE 132-35. Accordingly, although OPPOSER has belatedly served (and filed) deposition transcripts, the Board should order OPPOSER to file and serve properly marked exhibits for such transcripts.~~

**D.C. The Board Should Allow Applicant to Submit Evidence in Strict Response to any Amended or Supplemental Notice of Reliance**

Because Opposer has refused to cure the deficiencies in its Notice of Reliance despite ample time to do so, it does not require leave to file any supplemental notice or evidentiary submission. However, if the Board were to allow Opposer to submit any supplemental Notice of Reliance, it should allow Applicant a supplemental testimony period to submit evidence strictly responding to any new issues raised by such supplemental submission. Opposer argues that Applicant's request for a 60-day extension of its trial period following a Board order on Applicant's motion is excessive, because Opposer served deposition transcripts between 21 and 28 days late. Opp. at 9-10; 56 TTABVUE 10-11. However, when Applicant proposed a lesser extension, Opposer refused to agree to any additional evidentiary period to address new issues raised by any supplemental submission from Opposer. Matesky Reply Decl. ¶ 19. It appears that Opposer's true aim to prevent Applicant from rebutting any new issues raised by a supplemental submission. To the extent the Board authorizes any supplemental submission from Opposer, Applicant requests that it be allowed some period to submit evidence in strict response to new issues raised by such supplemental submission.

#### **IV. CONCLUSION**

For the reasons set forth above, Applicant requests that the Board **(1)** strike or disregard Exhibits I-K to OPPOSER's Notice of Reliance, **(2)** strike Opposer's Notice of Reliance, **(3)** order Opposer to file and serve properly labeled exhibits to the Goschie and King depositions, and **(4)** in the event the Board allows any amended or supplemental submission from Opposer, allow Applicant a supplemental testimony period to submit evidence in strict response to any new issues raised by such supplemental submission.

DATED: December 30<sup>8</sup>, 2020

Respectfully submitted:

MATESKY LAW<sup>PLLC</sup>

s/ Michael P. Matesky, II/

Michael P. Matesky, II  
(Washington Bar No. 39586)  
4500 9<sup>th</sup> Ave. NE, Suite 300  
Seattle, WA 98105  
Ph: 206.701.0331  
Fax: 206.702.0332  
Email: [mike@mateskylaw.com](mailto:mike@mateskylaw.com);  
[litigation@mateskylaw.com](mailto:litigation@mateskylaw.com)

Attorney for Applicant

**CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing on Opposer's counsel of record by email transmission to nancy.stephens@foster.com, pursuant to Trademark Rule § 2.119(b), 37 C.F.R. § 2.119(b).

Dated: December 8, 2020 \_\_\_\_\_  
s/ Michael P. Matesky, II  
Michael P. Matesky, II

\_\_\_\_\_  
\_\_\_\_\_

Formatted: Centered, Line spacing: single

Formatted: Normal, Centered, Indent: First line: 0", Line spacing: single, Tab stops: Not at 3.5"

Formatted: Centered, Line spacing: single

Formatted: Line spacing: single

Formatted: Centered, Line spacing: single

# EXHIBIT D

---

**Intel Corporation**

**v.**

**Felicia Wheeler-Sweet**

**Opposition No. 96, 517**

**application Serial No. 74/ 427, 409**

**United States Patent and Trademark Office,  
Trademark Trial and Appeal Board**

**May 18, 1999**

THIS DISPOSITION IS NOT CITABLE AS  
PRECEDENT OF THE TTAB

Filed on August 20, 1993

J. Paul Williamson of Arnold, White &  
Durkee for Intel Corporation.

Felicia Wheeler-Sweet, pro se.

Before Cissel, Chapman and Wendel,  
Administrative Trademark Judges.

### **OPINION**

Chapman, Administrative Trademark  
Judge:

An intent-to-use application was filed by Felicia Wheeler-Sweet on August 20, 1993 to register the mark INTELIMETRIC INCORPORATED on the Principal Register for services described as "consulting in the field of computers and computer programming." Applicant disclaimed the term "INCORPORATED."

Intel Corporation has opposed registration of the mark, alleging that opposer offers and sells a wide variety of computer hardware and software under the trade name INTEL CORPORATION and the trademark INTEL; that opposer incorporated under the name INTEL CORPORATION in 1968 and has continuously done business in interstate commerce under that name to the present; that opposer has offered and sold computer software products under the trade name INTEL CORPORATION since 1989; that opposer has offered and sold a variety of computer hardware products under the trademark INTEL (and formatives thereof) continuously

since 1969; and that applicant's mark, if used in connection with her services, would so resemble opposer's previously used trade name INTEL CORPORATION and opposer's various previously used and registered INTEL trademarks<sup>[1]</sup>, as to be likely to cause confusion, mistake, or deception.

Applicant denied the salient allegations of the notice of opposition.

The record consists of the pleadings; status and title copies of opposer's three pleaded registrations and seven additional registrations submitted under a notice of reliance; the testimony, with exhibits, of Jonathan Sharp, opposer's "manager brand strategy"; and the testimony, with exhibits, of Michele Andreetta, a trademark specialist with opposer. Applicant submitted no evidence or testimony.<sup>[2]</sup> Both parties filed briefs on the case.<sup>[3]</sup> No oral hearing was requested.

As noted above, in this case opposer has filed status and title copies of ten registrations, including its three pleaded registrations for the mark INTEL<sup>[4]</sup>, as well as two other registrations for the mark INTEL.<sup>[5]</sup> Opposer's other five registered marks are in the formats shown below:

Reg. Nos. 914, 978 and 1, 573, 324;  
<sup>[6]</sup>

INTEL INSIDE Reg. No. 1, 702, 463;<sup>[7]</sup>

Reg. No. 1, 705, 796;<sup>[8]</sup> and

Reg. No. 1, 945, 531.  
<sup>[9]</sup>

Because opposer owns valid and subsisting registrations<sup>[10]</sup> of its pleaded marks, the issue of priority does not arise. See *King Candy Company v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108 (CCPA 1974); and *Humana Inc. v. Humanomics Inc.*, 3 U.S.P.Q.2d 1696 (TTAB 1987). Moreover, the evidence clearly shows that opposer's first use preceded the filing date of applicant's intent-to-use application.



---

Thus, the sole issue before the Board is likelihood of confusion. Based on the record before us in this case, we find that confusion is likely.

Opposer corporation was founded in 1968 "to pursue business opportunities around the integrated circuit" (Sharp Dep., p. 15) and opposer's initial areas of focus were on memory devices. In 1971 opposer introduced its first microprocessor, and in 1980 IBM used that as the basic microprocessor in the IBM personal computer. Thus, by the 1980s opposer had shifted its business focus to logic products, such as the microprocessor; and by the end of the 1980s opposer had again shifted business focus to the personal computer business. Opposer's microprocessor remains a significant portion of opposer's business, but opposer makes "many other components that go into PC [personal computer] systems" (Sharp Dep., p. 18). Also, opposer develops new products for the PC platform including Internet cards, network management, and software, all sold under the INTEL marks and INTEL INCORPORATED trade name. Opposer sells its products to computer suppliers such as IBM, and other "embedded application-type manufacturers such as computer numerically controlled machines and other devices requiring electronic support." (Sharp Dep., p. 16). In addition, opposer sells products, such as overdrive processors and video phone and video conferencing type products, directly to PC users. Throughout the 1990s opposer's target audience has grown much broader, due to the expansion of the personal computer industry. Opposer considers its target audience to be all people over the age of twelve, essentially anyone who could purchase a PC.

Jonathan Sharp testified that opposer is also engaged in the business of consulting with respect to computers and computer programming in various ways. Opposer's employees educate and train students and teachers on technology subjects especially relating to the personal computer. Opposer develops markets for new technologies by working with industry people including independent hardware vendors and

independent software vendors, providing technical advice and software programming capability. Opposer also provides technical support and assistance getting opposer's video conferring products installed and running, as well as addressing issues that arise in the use of the product.

Opposer has between 1000-2000 licensees of its INTEL INSIDE Program. These licensees spend hundreds of millions of dollars advertising the INTEL INSIDE marks, and they place point-of-purchase materials bearing the various INTEL marks in over 2, 500 retail outlets worldwide (e.g., Circuit City, Best Buy, Comp U.S.A.).

Mr. Sharp testified that INTEL microprocessors are in 80% of the desk-top computers now in use. He further testified that opposer's worldwide sales of its products sold under its various INTEL marks were \$11 billion in 1994, \$16 billion in 1995, and \$20 billion in 1996. Advertising expenditures for the same years worldwide were between \$300 and \$600 million in 1994, just under \$650 million in 1995, and over \$650 million in 1996, with approximately 50% of those expenditures in the United States alone.

The record shows that opposer advertises its various products through radio, television (e.g., "Super Bowl," "Seinfeld," "Friends," "Star Trek: Next Generation," as well as MTV and Discover channels); print advertising including trade publications (e.g., *PC Week*, *PC Magazine*, *Byte*) and general interest publications (e.g., *National Geographic*, *Wall Street Journal*); and on the Internet through its own website as well as advertising on third-party websites. In addition, opposer sponsors civic events such as the promotion of the Smithsonian Institution's 150th anniversary.

In studies carried out in the United States by opposer to ascertain awareness of the INTEL and INTEL INSIDE brands, there was an 80% awareness of the brand among businesses and individuals who purchase PCs. In a 1995 study by a market research company conducted a study in which they analyzed, inter alia, the premium that people would pay on a typical PC system price in

---

order to get their brand of choice on certain elements of the PC, and the premium purchasers would pay for the INTEL brand microprocessor was over \$300. The record also shows that opposer's trademarks and trade name have regularly appeared, unsolicited, in stories in trade as well as general publications.

According to her application, applicant is located in the Washington, D.C. metropolitan area, and she intends to offer consulting services relating to computers and computer programming. Applicant has not furnished any evidence regarding her business or her activities under the mark. This is consistent with the fact that the application was filed based on applicant's claim that she intended to use the mark.

Our determination of likelihood of confusion must be based on our analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *See In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

The first relevant *du Pont* factor is the similarity or dissimilarity of the marks. Marks must be considered in their entirety; but in articulating reasons for reaching a conclusion on the question of likelihood of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature or portion of a mark. That is, one feature of a mark may have more significance than another. *See In re National Data Corporation*, 753 F.2d 1056, 224 U.S.P.Q. 749 (Fed. Cir. 1985).

In applicant's mark the word INCORPORATED is of little significance. Opposer's trade name INTEL CORPORATION and its various marks including INTEL, INTEL INSIDE and INTEL PROSHARE, and applicant's mark INTELIMETRIC INCORPORATED all include the root term INTEL. Although there are differences in appearance between applicant's mark and opposer's marks and trade name, there are significant similarities in that the parties' marks each start with INTEL as the first two syllables. Often the first part of a mark is the most likely part to be impressed upon the mind of the

purchaser and remembered. *See Presto Products Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1997 (TTAB 1988). Here INTELIMETRIC incorporates the root word, INTEL, from opposer's registered marks and opposer's trade name. Thus, the common significant element in the parties' marks is the same arbitrary element, INTEL. *See L. & C. Hardtmuth, Inc. v. Fabrique Suisse de Crayons Caran D'Ache S.A.*, 287 F.2d 599, 129 U.S.P.Q. 103 (CCPA 1961). Moreover, while applicant's mark is presented for registration in typed form, applicant could alter the actual presentation of the mark at any time by altering the style and/or size of the lettering, or highlighting or capitalizing the first two syllables of the term (i.e., **INTELIMETRIC** or **Intellmetric**) thereby increasing the emphasis on the first two syllables of the term. *See Jockey International Inc. v. Mallory & Church Corp.*, 25 U.S.P.Q.2d 1233 (TTAB 1992). We find that the marks are similar in sound and appearance.

The second relevant *du Pont* factor is the relatedness of the goods and/or services, as described in the application or registration(s), or in connection with which opposer has shown prior use of its mark or trade name. It is well settled that the involved goods/services need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that they are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer, or that there is an association between the producers of the goods or services. *See In re Melville Corp.*, 18 U.S.P.Q.2d 1386 (TTAB 1991), and *In re International Telephone & Telegraph Corp.*, 197 U.S.P.Q. 910 (TTAB 1978). Of course, there is no per se rule relating to likelihood of confusion in the computer field. *See In re Quadram Corp.*, 228 U.S.P.Q. 863 (TTAB 1985). Opposer's goods encompass a wide variety of computer-related products (e.g., microprocessors, microcomputers, computer software, technical manuals and user

and product manuals all relating to data technology and semiconductor devices, and computer hardware and peripherals therefor), as well as collateral products (e.g., plastic key chain tags, watches, jigsaw puzzles, towels, and clothing including t-shirts and caps). In addition, opposer has established that it provides consultation services involving education, innovation and technical support (questions which arise from the use of opposer's computer products). The services set forth in the application are consulting services in the field of computers and computer programming. We find that opposer's goods and services and the services identified in the opposed application are related. See *Peopleware Systems, Inc. v. Peopleware, Inc.* 226 U.S.P.Q. 320 (TTAB 1985) (PEOPLEWARE for consulting services in the field of computer selection, usage, design and development held to be confusingly similar to PEOPLEWARE for services involving the design, testing, and manufacture of microprocessor-based computer hardware and software products); and *In re Epic Systems Corporation*, 228 U.S.P.Q. 213 (TTAB 1985) (EPIC for computer time-driven relational data base programs and related documentation held to be confusingly similar to EPIC DATA for electronic data collection terminals and electronic data collection units).

Purchasers may assume, upon encountering applicant's computer consulting services, that opposer is now offering these specific consulting services through applicant as a licensee, or the services are in some way sponsored by or associated with opposer. See *Seligman & Latz, Inc. v. Merit Mercantile Corporation*, 222 U.S.P.Q. 720 (TTAB 1984).

The next relevant *du Pont* factors are the channels of trade and the similarity of purchasers. The Board must determine the issue of likelihood of confusion on the basis of the goods/services as identified. See *Canadian Imperial Bank of Commerce, N.A. v. Wells Fargo Bank*, 811 F.2d 1490, 1 U.S.P.Q.2d 1813 (Fed. Cir. 1987); and *In re Smith and Mehaffey*, 31 U.S.P.Q.2d 1531 (TTAB 1994). Although applicant asserted in her

brief that she will sell only to corporations, and will not sell to the general public, there are no such limitations in applicant's application. Therefore, the services set forth in applicant's application must be presumed to move through all normal channels of trade and are available to all potential customers. See *In re Elbaum*, 211 U.S.P.Q. 639 (TTAB 1981). Computer products, and consulting services in the field of computers and computer programming, with no restrictions, would normally be offered through similar, if not identical, channels of trade.

The next *du Pont* factor we look at in this case, the fame of the opposer's marks, is clearly established in opposer's favor. With recent annual worldwide sales exceeding \$20 billion dollars, recent annual United States advertising figures of \$325 million, and a showing that over 80% of PC buyers recognize the INTEL brand name, there is no question that opposer has established the fame of its involved marks for computer products. This record establishes that, given opposer's advertising and sales figures, opposer is a major player in the computer business, and that its INTEL and INTEL INSIDE marks for its various computer-related goods are famous. Thus, opposer's marks "enjoy a wide latitude of legal protection." See *Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453 (Fed. Cir. 1992). See also, *Nina Ricci S.A.R.L. v. E.T.F. Enterprises Inc.*, 889 F.2d 1070, 12 U.S.P.Q.2d 1901 (Fed. Cir. 1989); and *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 U.S.P.Q.2d 1698 (Fed. Cir. 1992).

The fame of opposer's marks increases the likelihood that consumers will believe that applicant's services emanate from or are sponsored by the same source.

Applicant's argument that there is no evidence of actual confusion is not persuasive. In this case applicant's application is based on her intent to use the mark, and she submitted no evidence of actual use. Even assuming applicant has commenced use of her mark in connection with her involved services, there is no evidence of the extent of such activities. Under the

circumstances this case presents, we simply cannot conclude that there has been an opportunity for confusion to occur. Moreover, the test is not actual confusion, but likelihood of confusion. *See Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (TTAB 1992).

Applicant, as the newcomer, had the obligation to select a mark which would avoid confusion. *See In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 U.S.P.Q.2d 1025 (Fed. Cir. 1988).

Based on the similarities in the parties' marks, the fame of opposer's marks, the relatedness of opposer's goods and services with the services specified in the application, and the similarity of the trade channels, we simply have no doubt that applicant's use of her mark for her services would be likely to cause confusion, mistake, or deception with opposer's marks, as well as opposer's trade name, as used on and in connection with opposer's various goods and services.

Decision: The opposition is sustained, and registration to applicant is refused.

-----

Notes:

[ 1 ] Opposer pleaded ownership of the following specific registrations ("among others") covering the mark INTEL: Reg. No. 938, 772, issued July 25, 1972, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years on July 25, 1992), for "equipment for the testing and programming of integrated circuits, registers and semiconductor memories." The claimed dates of first use are January 15, 1971.

Reg. No. 939, 641, issued August 1, 1972, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years August 1, 1992), for "integrated circuits, registers and semiconductor memories." The claimed dates of first use are March 11, 1969.

Reg. No. 1, 022, 563, issued October 14, 1975, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years on October 14, 1995), for "microcomputers, microcontrollers and microprocessors." The claimed dates of first use are July 6, 1971.

[ 2 ] Applicant did not attend opposer's depositions.

[ 3 ] In opposer's reply brief, opposer moved to strike applicant's brief as untimely, or alternatively to strike applicant's exhibit B, attached to her brief. Applicant's brief was filed one day late. This delay is clearly de minimis in nature, and there is no prejudice to opposer. Opposer's motion to strike applicant's brief is denied. However, opposer's alternative motion to strike applicant's exhibit B (a search report listing of third-party applications and/or registrations) is granted. This information was not timely and properly made of record during trial. Further, third-party registrations may not be made of record simply by filing a copy of a list or a search report. *See* TBMP §703.02(b) and cases cited therein. We have not considered applicant's exhibit B.

Finally, on page 8 of opposer's reply brief, opposer requested that the Board take judicial notice of a copy of a computer screen printout of applicant's website (attached to the reply brief as exhibit A). Alternatively, opposer requested that the exhibit be considered as relating to the credibility of applicant's "unsubstantiated" allegations throughout her brief. Opposer's request that we take judicial notice of applicant's website is denied. This is not the type of fact which may be judicially noticed. *See* Fed.R.Evid. 201(b), and TBMP §712.01. Opposer's exhibit A attached to its reply brief was not considered in reaching our decision herein.

[ 4 ] Reg. Nos. 938, 772; 939, 641; and 1, 022, 563, as more specifically identified in footnote 1.

[ 5 ] Reg. No. 1, 723, 243, issued October 13, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "metal key rings," with claimed dates of first use of October 16, 1990; "watches," with claimed dates of first use of October 15, 1990; "note paper, note cards, posters, microprocessor chip die plot prints as art prints, pencils, ball point pens, ink pens and stationery folders," with claimed dates of first use of October 22, 1990; "plastic key chain tags," with claimed first use dates of October 19, 1990; "mugs and water bottles sold empty," with claimed dates of first use of October 1, 1990; and "jigsaw puzzles, golf balls, golf tees and golf ball markers," with claimed dates of first use of September 27, 1990.

Reg. No. 1, 725, 692, issued October 20, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "all purpose sport bags, gym bags and carry-on bags," with claimed dates of first use of October 12, 1990; "towels," with claimed dates of first use of October 27, 1990; and "clothing, namely, t-shirts, coveralls, shirts and caps," with claimed dates of first use of October 1, 1990.

[ 6 ] Reg. No. 914, 978, issued June 15, 1971, Section 8 affidavit accepted, Section 15 affidavit acknowledged, renewed (for 10 years on June 15, 1991), for "integrated circuits, registers and semiconductor memories," with claimed dates of first use of March 11, 1969; and Reg. No. 1, 573, 324, issued December 26, 1989, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "printed material, namely, technical manuals, pamphlets, user and

---

product manuals, all of which relate to the field of information and data technology and semiconductor devices," with claimed dates of first use of August 1, 1973.

[ 7 ] Reg. No. 1, 702, 463, issued July 21, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "microprocessors," with claimed dates of first use of January 1992.

[ 8 ] Reg. No. 1, 705, 796, issued August 4, 1992, Section 8 affidavit accepted, Section 15 affidavit acknowledged, for "microprocessors," with claimed dates of first use of January 1992.

[ 9 ] Reg. No. 1, 945, 531, issued January 2, 1996, for "computer hardware and peripherals therefor, cameras and headsets, and computer software, for facilitating conferences among persons in different locations through the transfer of voices and visual images of participants and through the transfer of data among the participants," with claimed dates of first use of January 31, 1994.

[ 10 ] Status and title copies of four of the above-identified registrations (Reg. Nos. 1, 702, 463; 1, 705, 796; 1, 723, 243 and 1, 725, 692) submitted with opposer's notice of reliance were prepared by the Patent and Trademark Office in February 1997, and therefore do not include information as to the Section 8 affidavits, which were due on four separate dates in 1998. When a registration owned by a party has been properly made of record in an inter partes case, and there are changes in the status of the registration between the time it was made of record and the time the case is decided, the Board will take judicial notice of, and rely upon, the current status of the registration as shown by the records of the Patent and Trademark Office. See TBMP §703.02(a), at page 700-10, and the cases cited therein. The Board hereby takes judicial notice of the current status of the four involved registrations.

-----

**In re Charlene Corporation**  
**No. 87937460**  
**United States Patent and Trademark Office,**  
**Trademark Trial and Appeal Board**  
**September 15, 2020**

THIS OPINION IS NOT A PRECEDENT OF  
THE TTAB

Hoang Steve Ngo, Esq., for Charlene Corporation.

Alex Seong Keam, Trademark Examining Attorney, Law Office 114, Laurie Kaufman, Managing Attorney.

Before Bergsman, Heasley, and Coggins,  
Administrative Trademark Judges.

**OPINION**

Coggins, Administrative Trademark Judge

Charlene Corporation ("Applicant") seeks registration on the Principal Register of the mark CN (in standard characters) for "jewelry, namely, earrings, necklaces, tags for necklaces, chains, endcaps for chains, bracelets, rings, anklets, bangles, charms, pendants, hooks of charms, and hooks of pendants," in International Class 14.<sup>[1]</sup>

The Trademark Examining Attorney refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), on the ground that Applicant's mark, as applied to the goods identified in the application, so resembles the mark (Image Omitted) for "watches, clocks, travel alarm clocks; ornamental lapel pins; golf watches," in International Class 14,<sup>[2]</sup> on the Principal Register as to be likely to cause confusion, to cause mistake, or to deceive. When the refusal was made final Applicant requested reconsideration; then, after the Examining Attorney denied the request for reconsideration, Applicant appealed to this Board. We affirm the refusal to register.

**I. Procedural Issues**

Applicant's motion to reopen the time to file

its appeal brief is granted; and, in view thereof we accept the appeal brief, which was effectively filed one day late.<sup>[3]</sup> See Trademark Rules 2.142(b)(1) and 2.196. Similarly, we accept Applicant's amended reply brief, filed within the time the Board allowed for a substitute to the original reply brief, which was over-length.<sup>[4]</sup>

**II. Applicable Law**

Our determination of the issue of likelihood of confusion is based on an analysis of all the probative facts in evidence that are relevant to the factors set forth in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973) ("*DuPont*"). See also *In re Majestic Distilling Co.*, 315 F.3d 1311, 65 U.S.P.Q.2d 1201 (Fed. Cir. 2003). We consider each *DuPont* factor for which there is evidence and argument. See, e.g., *In re Guild Mortg. Co.*, 912 F.3d 1376, 129 U.S.P.Q.2d 1160, 1162-63 (Fed. Cir. 2019). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. See *In re Chatam Int'l Inc.*, 380 F.3d 1340, 71 U.S.P.Q.2d 1944, 1945-46 (Fed. Cir. 2004); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 U.S.P.Q. 24, 29 (CCPA 1976) ("The fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks.").

**A. The Number and Nature of Similar Marks for Similar Goods**

Before reaching the degree of similarity of the marks, we address Applicant's argument invoking the sixth *DuPont* factor, "[t]he number and nature of similar marks in use on similar goods," *DuPont*, 177 U.S.P.Q. at 567, as this may affect the scope of protection accorded the mark in the cited registration. The Federal Circuit has held that evidence of the extensive registration and use of similar marks by others in the field can be powerful evidence of a mark's weakness. *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. v. Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 U.S.P.Q.2d 1129, 1136 (Fed. Cir. 2015); *Juice Generation, Inc. v.*



*GS Enters. LLC*, 794 F.3d 1334, 115 U.S.P.Q.2d 1671, 1674 (Fed. Cir. 2015). The strength of a mark may be assessed based on its conceptual strength arising out of the nature of the mark itself and its commercial strength derived from the marketplace recognition of the mark. See *In re Chippendales USA, Inc.*, 622 F.3d 1346, 96 U.S.P.Q.2d 1681, 1686 (Fed. Cir. 2010).

Applicant argues that one third-party registration (No. 4954896 for the composite mark (Image Omitted) covering pompoms, hair band, hair barrettes, hair bows, hair grips, hair ornaments, and hair slides)<sup>[5]</sup> "presents evidence of commercial weakness of Registrant's (Image Omitted) mark." 4 TTABVue 13; 11 TTABVue 11. However, unlike cases in which the Federal Circuit found weakness based on "a considerable number of third parties[] use [of] similar marks," *Juice Generation*, 115 U.S.P.Q.2d at 1674, Applicant presented no evidence of actual use and thus no evidence of commercial weakness.

Similarly, Applicant did not submit evidence to show that the goods in the single third-party registration may be considered "similar" to the watches, clocks, and ornamental lapel pins in the cited registration, nor evidence that they are directed to the relevant public that comprises ordinary consumers of watches, clocks, and lapel pins. See *Omaha Steaks Int'l v. Greater Omaha Packing Co.*, 908 F.3d 1315, 128 U.S.P.Q.2d 1686, 1694 (Fed. Cir. 2018) (error to rely on third-party evidence of similar marks for dissimilar goods, as Board must focus "on goods shown to be similar"); *In re i.am.symbolic, llc*, 866 F.3d 1315, 123 U.S.P.Q.2d 1751, 1748 (Fed. Cir. 2017) (disregarding third-party registrations for goods in other classes where the proffering party "has neither introduced evidence, nor provided adequate explanation to support a determination that the existence of I AM marks for goods in other classes, . . . support[s] a finding that registrants' marks are weak with respect to the goods identified in their registrations").

Even if the one third-party registration could be considered relevant to conceptual weakness, it falls far short of the volume of evidence the Federal Circuit found convincing in *Jack Wolfskin*

and *Juice Generation*. See also *In re I-Coat Co., LLC*, 126 U.S.P.Q.2d 1730, 1735 (TTAB 2018) (three third-party uses are "well short of the volume of evidence found convincing in *Jack Wolfskin* and *Juice Generation*."); *In re Inn at St. John's, LLC*, 126 U.S.P.Q.2d 1742, 1745-46 (TTAB 2018) (two third-party registrations for related but not identical services and two registrations for identical services with a non-identical but similar mark were not sufficient to prove Registrant's mark was conceptually or inherently weak). Given the lack of evidence, we find this *DuPont* factor neutral.

## B. The Similarity or Dissimilarity of the Marks

Under the first *DuPont* factor, we compare Applicant's mark and the cited registered mark "in their entireties as to appearance, sound, connotation and commercial impression." *In re Vittera*, 671 F.3d 1358, 101 U.S.P.Q.2d 1905, 1908 (Fed. Cir. 2012) (quoting *DuPont*, 177 U.S.P.Q. at 567); see also *Palm Bay Imps. Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d 1689, 1691 (Fed. Cir. 2005). Here, the marks are legally identical because Applicant's mark is CN in standard characters while Registrant's mark is comprised of the same CN letters presented in a stylized format. Indeed, Applicant could display its standard character mark in any lettering style, color, or font, including the same font and style in which Registrant displays its mark. *In re i.am.symbolic, llc*, 123 U.S.P.Q.2d at 1748 ("Symbolic does not, and cannot, dispute that the mark, I AM in standard character form, and the registrants' marks, I AM in standard character, typed, or stylized form, are pronounced the same way and, at a minimum, legally identical."); *In re Vittera Inc.*, 101 U.S.P.Q.2d at 1909; *Citigroup Inc. v. Capital City Bank Grp., Inc.*, 637 F.3d 1344, 98 U.S.P.Q.2d 1253, 1258-59 (Fed. Cir. 2011).

Applicant's argument that its use of "normal letters" and "normal spacing" as opposed to Registrant's "specialized font style" with the letters "connected to each other by a link, bar or line that takes the place of the normal spacing

between [the two] letters," 4 TTABVUE 11, is unavailing. *SquirtCo v. Tomy Corp.*, 697 F.2d 1038, 216 U.S.P.Q. 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a difference cannot legally be asserted by that party."); *In re Strategic Partners Inc.*, 102 U.S.P.Q.2d 1397, 1399 (TTAB 2012). Due to the legal identity of the marks, the first *DuPont* factor weighs heavily in favor of finding a likelihood of confusion.

### C. The Goods, Trade Channels, and Classes of Purchasers

The second *DuPont* factor concerns the "similarity or dissimilarity and nature of the goods or services as described in an application or registration," *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 110 U.S.P.Q.2d 1157, 1159 (Fed. Cir. 2014), and the third *DuPont* factor concerns "[t]he similarity or dissimilarity of established, likely-to-continue trade channels." *Id.* at 1161 (quoting *DuPont*, 177 U.S.P.Q. at 567). We make our determination under these factors based on the goods as they are identified in the application and the cited registration. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531, 1534 (Fed. Cir. 1997); *Stone Lion*, 110 U.S.P.Q.2d at 1161; *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001 (Fed. Cir. 2002); *Octocom Sys., Inc. v. Hous. Comput. Servs., Inc.*, 918 F.2d 937, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990).

The legal identity of the marks reduces the degree of similarity between the goods required to support a finding of likelihood of confusion. *In re Shell Oil Co.*, 992 F.2d 1204, 26 U.S.P.Q.2d 1687, 1689 (Fed. Cir. 1993); *Time Warner Entm't. Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1661 (TTAB 2002); *In re Opus One Inc.*, 60 U.S.P.Q.2d 1812, 1815 (TTAB 2001).

In support of her argument that Applicant's goods are related to those of the cited Registrant, the Examining Attorney introduced approximately 10 use-based, third-party registrations showing that the same entity has registered a single mark

identifying the goods in both Applicant's and Registrant's identification of goods. For example:

Registration No. 5489655 (HERSHEY BEARS)

[6]

including jewelry, watches, ornamental lapel pins; Registration No. 5457502 (SEATTLE

SEAHAWKS)

[7]

including jewelry, watches, clocks, ornamental lapel pins; Registration No. 5544298 (ISUPERB)

[8]

including jewelry, watches, clocks, ornamental lapel pins; Registration No. 5485662 (AYERS & design)

[9]

including jewelry, watches, clocks, ornamental lapel pins; Registration No. 5497267 (VIGOR RIGGER)

[10]

including jewelry, watches, clocks, ornamental lapel pins; Registration No. 5507798 (FINEFEY & design)

[11]

including jewelry, watches, clocks, ornamental lapel pins; Registration No. 5544537 (LA FENG LONG)

[12]

including jewelry, wrist watches, ornamental lapel pins; Registration No. 5524582 (LOOLO)

[13]

including jewelry, watches, ornamental lapel pins; and Registration No. 5555641 (SECBOLT)

[14]

including various jewelry items (e.g., bangles, charms, earrings, chains, necklaces), watches, clocks, ornamental lapel pins.

As a general proposition, third-party registrations that cover goods from both the cited registration and an applicant's application are relevant to show that the goods are of a type that may emanate from a single source under one mark. *In re Country Oven, Inc.*, 2019 U.S.P.Q.2d 443903, \*8 (TTAB 2019) (citing, inter alia, *Detroit Athletic*, 903 F.3d 1297, 128 U.S.P.Q.2d 1047, 1051 (Fed. Cir. 2018); *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 62 U.S.P.Q.2d 1001, 1004 (Fed. Cir. 2002)).



In the absence of limitations in the application and cited registration, we must presume that the goods travel through all usual channels of trade and are offered to all normal potential customers. *In re i.am.symbolic, llc*, 123 U.S.P.Q.2d at 1750. The Examining Attorney adduced third-party Internet evidence in support of her position that the goods are sold in the same trade channels to the same classes of consumers, and are related in a manner that would lead relevant consumers to believe both sets of goods often come from a single source. The evidence includes screenshots from more than 12 entities selling both jewelry and watches, including:

([watchandjewelryexchange.com](http://watchandjewelryexchange.com))

[15]

Tysons Watch & Jewelry Exchange "sells upscale luxury goods" from third-parties including "jewelry, watches, gold & silver, artwork, and other luxury items." ([overstock.com](http://overstock.com))

[16]

Overstock sells various third-party jewelry and watches. On the "Jewelry & Watches" webpage, consumers can shop "Jewelry Categories" such as "Rings," "Earrings," "Necklaces," "Bracelets," "Men's Watches," "Women's Watches," and "Luxury Watches." Jewelry and watches appear side-by-side multiple places on this webpage.

([kay.com](http://kay.com))

[17]

Kay Jewelers sells various third-party jewelry and watches, including rings, necklaces, bracelets, earrings, charms, kid's watches, men's watches, and women's watches. ([jared.com](http://jared.com))

[18]

Jared, The Galleria of Jewelry is "a full service jeweler" which sells various third-party jewelry and watches. ([itshot.com](http://itshot.com))

[19]

Its Hot Diamond Store NY "specialize[s] in the creation and wholesale of a wide array of exquisite designs of Men's Diamond Watches, Women's Diamond Watches, and Diamond Jewelry including Rings, Earrings, Bracelets, Necklaces, Pendants, and more." It "offer[s]

genuine diamond watches and a full line of Mens & Womens [sic] Diamond Jewelry." and others as listed in the Examining Attorney's brief. See 8 TTABVue 9-10. Because this evidence focuses on jewelry and watches, we note that Examining Attorney need not prove, and we need not find, similarity as to each and every good listed in the Class 14 identification of goods. It is sufficient for a refusal based on likelihood of confusion that relatedness is established for any item encompassed by the identification of goods in the application and registration. See *Tuxedo Monopoly, Inc. v. Gen. Mills Fun Grp.*, 648 F.2d 1335, 209 U.S.P.Q. 986, 988 (CCPA 1981); *In re i.am.symbolic, llc*, 116 U.S.P.Q.2d 1406, 1409 (TTAB 2015); *Inter IKEA Sys. B.V. Akea, LLC*, 110 U.S.P.Q.2d 1734, 1745 (TTAB 2014).

Applicant asserts that its jewelry is worn "directly on the body" and "for fashionable or stylish purposes," while Registrant's watches are used "for a 'functional' purpose." 4 TTABVue 11. As a result, Applicant posits that its decorative jewelry goods "are different or dissimilar from" Registrant's functional goods. *Id.* But the record reflects that watches are more than functional - they are also fashionable and stylish. For example, Jared, The Galleria of Jewelry states that "we realize that a timepiece is about so much more than time. A watch is a piece of jewelry that reflects your style, your passion for elegance and craftsmanship." [20] Similarly, Kay Jewelers markets "[w]atches [as] a classic and sophisticated accessory that pair[s] well with both fancy and casual looks." [21] Moreover, it is well known that watches, especially those containing gemstones, are considered a form of jewelry. See *Monocraft, Inc. v. Leading Jewelers Guild*, 173 U.S.P.Q. 507, 507 n.4 (TTAB 1972) ("Watches' include all types thereof including ornamental watches which can be worn as costume jewelry"); *c.f. Gruen Indus., Inc. v. Ray Curran & Co.*, 152 U.S.P.Q. 778, 779 (TTAB 1967) (watches and men's jewelry are "clearly so related").

Applicant argues that its goods will be sold only at jewelry stores ("an online jewelry website and in wholesale and retail jewelry stores") while Respondent's goods are offered online only and

at a specific website and "with many other non-jewelry items." 4 TTABVUE 12; 11 TTABVUE 9. However, because neither Applicant's nor Registrant's identification of goods is limited to any trade channel or potential consumer, we must presume that the goods travel through all usual channels of trade and are offered to all normal potential customers. "We have no authority to read any restrictions or limitations into the registrant's description of goods." *In re Thor Tech Inc.*, 90 U.S.P.Q.2d 1634, 1638 (TTAB 2009).

Based on the aforementioned evidence, we find that Applicant's jewelry is closely related to Registrant's watches because these goods serve at least one of the same purposes, namely, personal ornamentation and style, and they are offered together in the same trade channels to the same types of purchasers.

Applicant asks us to compare this appeal with *In re Thor Tech, Inc.*, 113 U.S.P.Q.2d 1546 (TTAB 2015). See 11 TTABVUE 7. However, the record in *Thor Tech* differs substantially from the record in this appeal. The record in *Thor Tech* (1) included only two third-party registrations to show a relationship between the involved goods which were rebutted by 50 sets of third-party registrations for the same or similar marks registered for the cited registrant's goods on the one hand and the applicant's goods on the other, owned by different entities; (2) did not establish overlapping channels of trade, and (3) established that the applicant's and registrant's goods were expensive, with prices ranging from approximately \$8, 000 - \$40, 000. That is in great contrast to the evidence in this appeal, which is more than enough to indicate that the goods at issue are related, and where Applicant offers no countervailing evidence such as that offered in *Thor Tech*. We conclude that Applicant's goods and those of the cited Registrant are related. Accordingly, we find that the second and third *DuPont* factors favor a finding of likelihood of confusion.

#### D. Summary on Likelihood of Confusion

The first, second, and third *DuPont* factors

favor a finding of likelihood of confusion; the sixth factor is neutral. As Registrant's mark is inherently distinctive and has not been shown to be commercial or conceptually weak, the marks at issue are legally identical, and the goods are related and would travel in overlapping trade channels to the same or overlapping classes of purchasers, we find that Applicant's mark CN, used in connection with Applicant's jewelry goods, so closely resembles the registered mark CN as to be likely to cause confusion, mistake or deception as to the source of Applicant's goods.

#### III. Decision

The refusal to register Applicant's mark **CN** is affirmed.

-----

Notes:

[ 1 ] Application Serial No. 87937460 was filed on May 26, 2018, under Section 1(b) of the Trademark Act, 15 U.S.C. § 1051(b), based upon Applicant's allegation of a bona fide intention to use the mark in commerce.

[ 2 ] Registration No. 3698988, issued October 20, 2009; Combined Section 8 Affidavit and Section 9 Renewal received. The cited registration contains goods in other classes not at issue in this refusal.

[ 3 ] 6 TTABVUE (motion), 4 TTABVUE (brief). Citations to the briefs and other materials in the appeal record refer to the Board's TTABVUE docket system. Citations to the prosecution file refer to the downloadable .pdf version of the TSDR record.

[ 4 ] 11 TTABVUE (amended reply), 10 TTABVUE (Board order).

[ 5 ] Applicant did not submit a copy of the listed third-party registration or its electronic equivalent as necessary to make the registration of record. *In re City of Houston*, 101 U.S.P.Q.2d 1534, 1536 n.5 (TTAB 2012). The Examining Attorney, however, did not object, and acknowledges as much, 8 TTABVUE 11 n.1, so we deem any such objection waived. *In re ActiveVideo Networks, Inc.*, 111 U.S.P.Q.2d 1581, 1594 n.40 (TTAB 2014) (objection waived where examining attorney, in a continuing refusal, failed to advise applicant that mere listing of third-party registrations was insufficient to make them of record); *In re HSB Solomon Assoc., LLC*, 102 U.S.P.Q.2d 1269, 1273 (TTAB 2012); *City of Houston*, 101 U.S.P.Q.2d at 1536 ("[T]he examining attorney's failure to advise applicant of the insufficiency of the list of registrations when it was proffered during examination constituted a waiver of any objection to consideration of that

---

list.") (citing *In re Broyhill Furniture Indus., Inc.*, 60 U.S.P.Q.2d 1511 (TTAB 2001). Accordingly, we have considered Applicant's reference to the third-party registration, which is of limited probative value because we are unable to verify its contents.

[[6](#)] September 17, 2018 Office Action at TSDR 9.

[[7](#)] *Id.* at 12.

[[8](#)] *Id.* at 15.

[[9](#)] *Id.* at 17.

[[10](#)] *Id.* at 20.

[[11](#)] *Id.* at 22.

[[12](#)] *Id.* at 25.

[[13](#)] *Id.* at 28.

[[14](#)] *Id.* at 33.

[[15](#)] September 17, 2018 Office Action at TSDR 36-40.

[[16](#)] *Id.* at 41-49.

[[17](#)] *Id.* at 50-53.

[[18](#)] *Id.* at 54-58.

[[19](#)] July 22, 2019 Office Action at TSDR 12.

[[20](#)] September 17, 2018 Office Action at TSDR 54 (jared.com)

[[21](#)] September 17, 2018 Office Action at TSDR 52. (kay.com).

-----

---

**Virgin Enterprises Limited**

**v.**

**Albion Motors Ford Mercury, Inc.**

**Opposition Nos. 91153575, 91153612,  
91154161**

**Application Serial Nos. 76256596, 7625149,  
76256597**

**United States Patent and Trademark Office,  
Trademark Trial and Appeal Board**

**August 10, 2007**

THIS OPINION IS NOT A PRECEDENT OF  
THE TTAB

James Dabney, Victoria J.B. Doyle, Carrie B. Kingsley and Randy Eisensmith of Fried, Frank, Harris, Shriver & Jacobson LLP for Virgin Enterprises Limited.

Daniel Van Dyke and Karl D. Ondersma of Van Dyke, Gardner, Linn & Burkhart, LLP for Albion Motors Ford Mercury, Inc.

Before Hairston, Drost and Walsh,  
Administrative Trademark Judges.

**OPINION**

Walsh, Administrative Trademark Judge:

In these consolidated proceedings, Virgin Enterprises Limited (opposer) opposes three intent-to-use applications filed by Albion Motors Ford Mercury, Inc. (applicant) to register the marks VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE on the Principal Register in standard-character form. In all three applications applicant identifies its services as "automobile and truck dealerships" in International Class 35. Also, in each of the respective applications applicant disclaims the words "VEHICLE," "PURCHASE" and "SALE."

The notices of opposition are identical in all respects other than in the references to the specific application at issue. As grounds for the oppositions opposer asserts both likelihood of confusion under § 2(d) of the Trademark Act of 1946, 15 U.S.C. § 1052(d), and dilution under § 43(c) of the Act, 15 U.S.C. § 1125(c). In the

notices of opposition opposer states, "Opposer, VEL, and its related companies (collectively, the "Virgin Group"), are now and for many years past have been engaged in the sale and distribution of a wide variety of goods and services under the world-famous VIRGIN mark." Notices of Opp. at ¶ 1. The notices state further that the goods and services offered under the VIRGIN mark include, among others, airline services, transportation services, travel-related services, cargo services, retail store services, alcoholic and nonalcoholic beverages, telecommunications products and services, clothing, luggage, compact discs, computer games, umbrellas, books, records, CDs, audio tapes and videotapes. Opposer relies on several registrations for its VIRGIN marks in these proceedings. *Id.* at ¶ 2. In its answers applicant has denied the essential allegations in the notices of opposition.

*I. The Record*

The record in these consolidated proceedings is enormous. The record includes the files of the three opposed applications and the pleadings in these proceedings. In addition, opposer filed trial testimony from nine witnesses, including eight officials connected with opposer and one official connected with applicant, along with hundreds of exhibits consisting of thousands of documents, as well as evidence in electronic form. Both opposer and applicant have filed notices of reliance, each relying on hundreds of documents.

Opposer and applicant have filed briefs.

*II. Applicant's Objections*

Before we address the merits, we must dispose of numerous evidentiary and procedural objections and motions. In its brief applicant lists twenty-eight separate objections related to opposer's main brief and opposer's evidence.

Opposer has also filed a motion requesting acceptance of its reply brief which was filed one day late. The reply brief was due on Friday, July 7, 2006. Opposer filed the reply brief electronically, and it was received in the USPTO

---

on Saturday, July 8, 2006. Applicant opposes the motion for acceptance of opposer's late-filed reply brief.

Also, at the close of opposer's testimony period, applicant filed a motion to strike certain documents opposer submitted under its notice of reliance. In an action dated November 21, 2005 on that motion, the Board deferred action with respect to applicant's substantive objections and sustained certain objections as to the form of opposer's notice of reliance. In that action, the Board advised applicant that applicant must raise the substantive objections in applicant's trial brief. In accordance with the Board action, opposer has resubmitted the notice of reliance with corrections as to form. Accordingly, we will assume that applicant has raised all remaining substantive objections regarding the evidence, as directed, in applicant's brief. See *Kohler Co. v. Baldwin Hardware Corp.*, 82 U.S.P.Q.2d 1100, 1104 (TTAB 2007).

First we will address the objections and motion related to the consideration of opposer's briefs. In objection 11, applicant objects to our consideration of opposer's main brief on the ground that opposer failed to serve the brief on applicant in accordance with 37 C.F.R. § 2.119(d). Applicant's Brief at 37. More specifically, applicant asserts that opposer served its main brief on applicant by email, a means of service not provided for in the rules, though permitted if the parties agree to service by email. Applicant further asserts that applicant had not agreed to receipt of opposer's main brief by email. It is apparent that applicant did receive opposer's main brief on time. Applicant, in fact, responded to opposer's main brief. In view of the totality of the circumstances, we exercise our discretion to accept and consider opposer's main brief. We find that the email transmission in no way prejudiced applicant. In fact, it appears that applicant received the brief sooner than it would have if the brief had been mailed. Nonetheless, we urge parties to discuss and reach an agreement concerning these logistics to avoid unnecessary disputes over form.

Opposer has filed a motion requesting

acceptance of its reply brief, which was apparently filed one day late. While applicant has objected to the acceptance of opposer's reply brief, it has not pointed to any prejudice to itself. Under the circumstances of this case, we grant opposer's motion to accept its reply brief although we add, the brief does not change the outcome of this case.

Next, in applicant's objection 1, applicant objects to "... any attempted reliance by VEL [opposer] to any registrations or applications or other purported marks that were not pleaded in VEL's Notice of Opposition." Applicant's Brief at 33. Applicant's objection is well taken, and accordingly we sustain the objection.

Furthermore, applicant notes that opposer referred to eighteen registrations and three applications for VIRGIN marks in each of the notices of opposition, and that opposer provided status and title copies of only eighteen registrations under opposer's notice of reliance. With its notice of reliance opposer did provide status and title copies of numerous additional registrations which opposer failed to plead in the notices of opposition. Opposer made no attempt to amend its notice of opposition for this purpose. Accordingly, for the purposes of these proceedings, we have limited our consideration to the marks and goods and services covered by the eighteen registrations owned by opposer which opposer both pleaded in its notices of opposition, and as to which opposer filed status and title copies in its notice of reliance. We identify the particulars of those eighteen registrations below. We hasten to add that applicant has vastly underestimated the importance and scope of these eighteen registrations as we discuss below.

We note further that the marks in these eighteen registrations are the only VIRGIN marks which opposer has pleaded. Therefore, in accordance with applicant's objections, we also have limited our consideration in these proceedings to those marks identified in the eighteen registrations. This determination effectively disposes of applicant's objections 2 and 3 related to evidence regarding the VIRGIN LIMO mark, one of the VIRGIN marks which

---

opposer failed to plead.

Next in objections 4 and 5 applicant objects to certain of opposer's evidence related to its use of the VIRGIN marks with respect to limousine services. *Id.* at 35. We note that among the eighteen VIRGIN registrations before us are opposer's Reg. No. 1851817 for the mark VIRGIN in standard-character form and Reg. No. 1852776 for the VIRGIN mark in special form shown below. Each covers, among other services, "transportation of ... passengers by road..." Also, Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form, which is also before us, covers, among other services, "transportation of ... passengers by road ... transportation of human beings by means of land vehicles ... chauffeur services." Therefore, opposer's registrations effectively cover use of the VIRGIN marks with respect to limousine services. Accordingly, we need not and do not rely on any other evidence, including the evidence applicant objects to here, for the purpose of opposer's use of the VIRGIN marks with respect to limousine services.

In objection 6, applicant objects to Opposer's Test. Exh. 13, a brochure promoting certain services under the VIRGIN ATLANTIC and VIRGIN marks for lack of foundation because Mr. Bershefsky, the authenticating witness, indicated that he did not know whether the brochure had been distributed to the public. *Id.* at 36. We sustain the objection; we have not considered this brochure in reaching our decision here.

In objection 7, applicant objects to the testimony from opposer's witness, Mr. Block, with regard to the number of "views" of bags used by Virgin Megastores, as speculative. *Id.* We sustain the objection. We will consider only the number of bags in our decision of the case.

In objection 8, applicant objects to "opposer's reliance on Board proceedings and court proceedings to establish the fame of its mark." *Id.* We sustain the objection to the extent that we will not adopt any findings of fact or conclusions of law reached in those proceedings.

The parties, marks and evidence in those proceedings differ from those in the proceedings before us. We will consider the evidence of these proceedings for the limited purpose of evaluating the extent to which opposer has policed the VIRGIN marks, and for whatever bearing those policing efforts might have on the strength of opposer's VIRGIN marks.

In objection 9 applicant objects to "... any attempted reliance by VEL to (sic) the 'VIRGIN SALE' mark." *Id.* We sustain the objection; opposer did not plead the VIRGIN SALE mark.

In objection 10 applicant objects to opposer's reliance on Test. Exh. 212, the book *The World's Greatest Brands, an International Review by Interbrand* as hearsay. *Id.* at 37. We overrule the objection. Opposer's witness, Ms. Levin-Hyams, adequately authenticated the publication. Furthermore as to the hearsay issue, we regard this and similar publications both opposer and applicant have submitted as being submitted to show that the content of the publications appeared before the public, not for the truth of that content. To the extent applicant raises hearsay objections in any of its enumerated objections to any other similar publications opposer placed in evidence, we likewise overrule those objections.

With regard to applicant's objection 12 to opposer's submission of additional pages from the article in Exh. 141 to Opposer's Notice of Reliance, we sustain the objection. *Id.* at 38. We will not consider the additional pages to the exhibit which opposer provided only with its substitute notice of reliance.

In objection 13, applicant objects to Exhs. 147-150 to Opposer's Notice of Reliance. *Id.* We first note that opposer withdrew Exh. 147 when it filed its substitute notice of reliance. As to Exhs. 148 to 150, we sustain applicant's objection on the grounds that the printouts from certain web sites are not proper subject matter for a notice of reliance under 37 C.F.R. § 2.122 because they are copies from web sites and, as applicant alleges, there is no indication in the record that these materials are available to the public in

---

printed form.

In objection 14 applicant objects to Exhs. 135, 139, 145, 146 and 151 to Opposer's Notice of Reliance. *Id.* With regard to Exhs. 135, 139 and 151 applicant asserts that the publications are not generally available to the public because the documents state that they are published in the United Kingdom, with no indication that they were distributed or otherwise available in the United States. We concur and sustain the objection with regard to this evidence. *In re Societe Generale des Eaux Minerales de Vittel S.A.*, 1 U.S.P.Q.2d 1296, 1298 n.3 (TTAB 1986), *aff'd*, 824 F.2d 957, 3 U.S.P.Q.2d 1450 (Fed. Cir. 1987).

With regard to Exhs. 145 and 146, applicant does not explain specifically why we should not regard these publications as generally available to the public. In fact, each of these documents bears a stamp indicating that the documents were obtained through the Burrelle's clipping service and an indication of the publication name, and the date and place of publication, indicating that both were published in the United States. We overrule the objection as to these exhibits.

In objection 15 applicant objects to opposer's Test. Exh. 1 for failure to authenticate and lack of foundation. *Id.* at 39. The exhibit is a printout from opposer's web site. We overrule the objection. The authenticating witness, Mr. Bershefsky, an official with Virgin Atlantic Airlines, one of the Virgin Group companies, is competent to recognize and authenticate a printout from a Virgin Group web site, even though he did not print it out himself and even though he did not know precisely who did print it out.

In objection 16 applicant objects to Test. Exh. 3 "to the extent the document contains merely prospective budgeted advertising figures." *Id.* at 40. We sustain the objection.

In objection 17 applicant objects to Test. Exh. 4 because it is an advertisement which which ran in the United Kingdom only, and on other grounds. *Id.* We sustain the objection on the grounds that there is no evidence that the

advertisement was run or seen in the United States.

In objection 18 applicant objects to Test. Exh. 5 arguing that opposer's authenticating witness, Mr. Bershefsky, testified that it was "not an advertisement." *Id.* In its argument applicant quotes the witness in misleading fashion. In cross examination, the witness explains quite clearly, "...this piece as we were describing was used to - used within specific companies or places we were going to alert the people in the company that the road trip truck was outside the location." Bershefsky Test. at 121-122. The exhibit is clearly admissible as a promotional piece to show how opposer promoted its mark in relation to airline services, the focus of the "road trip" promotion. Accordingly, we overrule the objection.

In objection 19 applicant objects to opposer's Test. Exhs. 22-28 for failure to authenticate and lack of foundation. *Id.* The exhibits are copies of a promotional piece, duty-free catalogs and inflight magazines used in conjunction with opposer's airline services. Applicant argues that the exhibits should be excluded because the authenticating witness did not create them or retrieve them from the company archive personally. The witness, Mr. Bershefsky, as the brand marketing manager for Virgin Atlantic Airlines, is competent to recognize and authenticate these documents. We overrule the objection.

In objections 20 and 21, applicant objects to Test. Exhs. 214-217, 235 and 236 as hearsay, for failure to authenticate and/or for lack of foundation. *Id.* at 41. The exhibits are portions of various published books about Richard Branson, the principal owner of and moving force behind the Virgin Group of companies, or about the Virgin Group's brands. We overrule the objections. The books would qualify for submission under a notice of reliance under 37 C.F.R. § 2.122. It would be illogical to exclude the same type of material when introduced by a witness - here Ms. Levin-Hyams, an official with the Virgin Group of companies. We will consider the material for whatever probative value it



---

possesses.

In objection 22 applicant objects to Test. Exh. 239 because "VEL's identifying witness testified that she did not know where the exhibit came from." *Id.* In fact, the witness, again Ms. Levin-Hyams, testified that the article came from Bacon's clipping service. We overrule the objection.

In objections 23 and 24 applicant objects to Opposer's Test. Exhs. 240 and 241 which are CDs containing footage related to Virgin Group promotional activities. *Id.* Although Ms. Levin-Hyams testified that she was familiar with the content applicant objects because the witness did not personally witness the transfer of the material to CDs for submission in the case. We overrule the objection.

In objection 25 applicant objects to Opposer's Test. Exhs. 242 and 243, copies of articles regarding the Virgin Group from the *New York Times* because the authenticating witness, again Ms. Levin-Hyams, did not clip and copy the articles herself. *Id.* at 42. In fact, the witness testified that she had read the articles herself when they appeared and directed the copying of the articles; she thus went beyond what would be required to authenticate the exhibits under the circumstances. We overrule the objection.

In objection 26 applicant objects to Test. Exhs. 244 and 245, copies of pages from the Fox TV website promoting "The Rebel Billionaire - Branson's Quest for the Best" again because Ms. Levin-Hyams, the authenticating witness, did not personally obtain the copies. *Id.* The witness testified that she had the pages in her own records and recognized them. We overrule the objection.

In objection 27 applicant objects to Test. Exh. 57 because opposer failed to provide a copy to applicant. The exhibit appears to be a media plan for August 2004 related to future advertising of the Virgin Megastores. Opposer did not respond to this objection in its reply brief. Accordingly, we sustain the objection.

In objection 28 applicant objects to Test. Exhs. 1 through 248, which includes all such exhibits, for failure to make the exhibits available prior to the testimonial depositions and for failure to supplement answers to certain related interrogatories propounded by applicant. We overrule the objections.

Opposer was under no obligation to make exhibits presented through testimony available to applicant in advance of the testimonial depositions. Applicant elected to take part in the depositions by telephone. Applicant could have attended the depositions and viewed the exhibits at that time. Furthermore, it appears most of the exhibits were made available to applicant prior to or at the time of the depositions, as evidenced by the extensive cross examination applicant conducted with regard to specific exhibits. There is no evidence that opposer intentionally withheld documents. In fact, it appears that opposer tried to accommodate applicant when problems arose - problems which are inevitable when so many documents are involved.

Furhermore, we will not entertain a global objection of this sort based on failure to meet discovery obligations without particulars as to the exhibits and other circumstances, including evidence as to responses and documents which were, in fact, provided during discovery. Cf. *Kohler Co. v. Baldwin Hardware Corp.*, 82 U.S.P.Q.2d at 1106. See also *CareFirst of Maryland Inc. v. FirstHealth of the Carolinas Inc.*, 77 U.S.P.Q.2d 1492, 1500 (TTAB 2005).

Finally, we note that opposer has referred to certain uses of its VIRGIN marks outside the United States in its notices of opposition and in its arugments. Furthermore, certain of opposer's evidence either relates to use outside the United States or comingles use within and outside the United States. Although applicant has not specifically objected to these claims or opposer's evidence on this ground, we note here that we have not considered any use by opposer of its marks outside the United States nor any evidence relating to such use in reaching our decision here.

### *III. Standing*



Opposer has shown that it has used the VIRGIN marks in the United States and that it is the owner of numerous U.S. registrations for those marks. Accordingly, opposer has established standing. *See generally Jewelers Vigilance Committee Inc. v. Ullenberg Corp.*, 823 F.2d 490, 2 U.S.P.Q.2d 2021, 2023 (Fed. Cir. 1987).

#### IV. Priority

For purposes of the likelihood-of-confusion claim, priority is not at issue in these proceedings. Opposer has made of record valid and subsisting registrations for various VIRGIN marks which it owns. *See King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 U.S.P.Q. 108, 110 (CCPA 1974).

#### V. Findings of Fact

At the outset we note that both opposer and applicant have submitted certain information regarding their businesses, principally specific financial information, under claims of confidentiality. Both parties' claims are appropriately narrow and within reason, and therefore we will respect those claims. Consequently, we are somewhat constrained in our discussion of specific information regarding the activities of both parties.

##### A. Opposer

Opposer is the owner of various marks consisting in whole or in part of the word VIRGIN which it uses through a number of related companies. The related companies include the Virgin Group of companies, referenced above, which are substantially owned and controlled by Richard Branson, and certain licensees not owned by Mr. Branson. James Test. at 6. The scope of the businesses which the Virgin Group operates is expansive to say the least; there are in excess of 200 businesses. Test. Exh. 95.

More importantly for our purposes, as noted above, opposer is the current owner of eighteen valid and subsisting registrations for the VIRGIN marks which are in evidence in these

proceedings. Those registrations include the following:

Reg. No. 1413664 for the mark VIRGIN in standard-character form for air travel services, in International Class 39; Reg. No. 1469618 for the mark VIRGIN in standard-character form for pre-recorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records, in International Class 9; Reg. No. 1597386 for the mark VIRGIN in standard-character form for printed sheet music; mounted photographs; posters, fictional and non-fictional books, biography and autobiography books, periodicals, namely, journals, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; stationery and office supplies, playing cards, in International Class 16, and belts, articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts, in International Class 25; Reg. No. 1851817 for the mark VIRGIN in standard-character form for transportation of goods and passengers by road, air freight transportation services; travel agency services, in International Class 39; and bars; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus, and watches, sheet music, books and photography, handbags, purses, luggage and leather goods, clothing, games, video game machines and video game cartridges, in International Class 42; Reg. No. 2586162 for the mark VIRGIN in standard-character form for articles of luggage, namely, suitcases; bags; namely, back packs, rucksacks, school bags, school satchels, travelling bags, sports bags, all purpose sports bags for campers and climbers, textile shopping bags; wallets; umbrellas and parasols, in International Class 18; Reg. No. 2625455 for the mark VIRGIN in standard-character form for providing an on-line shopping mall via a global computer network; providing business information via a global computer network, in International Class 35, and

computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business, in International Class 38; Reg. No. 1517801 for the mark shown below for prerecorded audio and/or video tapes, cassettes and cartridges; pre-recorded audio and video discs, phonograph records; photographic and cinematographic films, in International Class 9;  
(Image Omitted)

Reg. No. 1591952 for the mark shown below for printed sheet music; fictional and non-fictional books, biography and autobiography books, periodicals, namely, paperback books all dealing with music, films and entertainment; paper for packaging, paper cases; writing instruments, namely, pens, pencils, ball point pens, stationery and office supplies, namely, writing and note paper, playing cards, in International Class 16, and articles of outer clothing, namely, shirts, t-shirts, sweat shirts, jackets, hats, clothing caps, clothing belts, in International Class 25;  
(Image Omitted)

Reg. No. 1852776 for the mark shown below for transportation of goods and passengers by road, air freight transportation services, in International Class 39; and bars; rental of food service equipment; namely, vending machines; portrait and aerial photography; typesetting and printing services; and retail store services in the fields of cameras, records, audio and video tapes, computers and electronic apparatus; and watches; sheet music, books and photography; handbags, purses, luggage and leather goods; clothing; games, video game machines and video game cartridges, in International Class 42;  
(Image Omitted)

Reg. No. 2600080 for the mark shown below for nonalcoholic beverages, namely, soft drinks, in International Class 32, and stating "The drawing of the trademark is lined for the color red.";  
(Image Omitted)

Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form for transportation of and arranging transportation of goods and passengers by road, rail, air and sea; transportation of human beings by means of land vehicles; automobile and motorcycle rental services; chauffeur services; tourist agency services; travel agency services, namely, making reservations and bookings for transportation; arranging and/or conducting travel tours; and arranging visits to places of interest, in International Class 39, and making hotel reservations for others; arranging, organizing and providing facilities for exhibitions and conferences; and providing beauty salons and hairdressing, massage, manicure and pedicure services, in International Class 42, with "VACATIONS" disclaimed; Reg. No. 2488605 for the mark VIRGIN CARGO WINGS in standard-character form for freight airline services; arranging of transportation of goods by air; packaging and storage of goods, in International Class 39, with "CARGO" disclaimed; Reg. No. 2536973 for the mark shown below for charitable fundraising, in International Class 36, with "HEALTHCARE FOUNDATION" disclaimed;  
(Image Omitted)

Reg. No. 1863353 for the mark VIRGIN MEGASTORE in standard-character form for retail department store services, in International Class 42, with "MEGASTORE" disclaimed; Reg. No. 2237092 for the mark VIRGIN VACATIONS in standard-character form for arranging the transport of passengers by air and road, arranging and conducting travel tours, travel agency services, namely, making reservations and bookings for transportation, and transportation reservation services, in

International Class 3 9; and resort hotel and hotel reservation; travel agency services, namely, making reservations and bookings for temporary lodging, in International Class 42; Reg. No. 2151589 for the mark VIRGIN VODKA in standard-character form for vodka, in International Class 33, with "VODKA" disclaimed; Reg. No. 2507654 for the mark shown below for nonalcoholic beverages, namely, soft drinks, and syrups and preparations for making soft drinks, in International Class 32, and spirits, in International Class 33, with "TRADING COMPANY" disclaimed;  
(Image Omitted) and

Reg. No. 2639079 for the mark VIRGIN HOLIDAYS in standard-character form for transportation of passengers and goods by road, rail and air; arranging of package holidays; arranging and organizing tours; arranging visits to places of interest; tourist office services; travel agency services, namely, making reservations and bookings for transportation; transportation reservation services, in International Class 3 9 and travel agency services, namely, making reservations and bookings for temporary lodging, in International Class 43, with "HOLIDAYS" disclaimed.

Applicant has, perhaps, overlooked the forest for the trees in presenting its case. The scope and importance of these eighteen registrations cannot be underestimated. The registrations, shown above, cover a significant number of variations on the VIRGIN marks. More importantly, the registrations for marks which consist of either VIRGIN alone in standard-character form or of VIRGIN alone in stylized script cover a vast variety of goods and services. They identify services ranging from transportation and travel, to bar services, to communications services, to online sales and retail store services for a wide variety of goods. The goods identified in the registrations range from audio and video recordings in varied forms, to clothing, to luggage, to publications, to stationary and office supplies, to alcoholic and nonalcoholic

beverages.

As we stated above, among the eighteen VIRGIN registrations before us are opposer's Reg. No. 1851817 for the mark VIRGIN in standard-character form and Reg. No. 1852776 for the VIRGIN mark in special script. Each covers, among other services, "transportation of ... passengers by road..." Also, Reg. No. 2482726 for the mark VIRGIN ATLANTIC VACATIONS in standard-character form, which is also before us, covers, among other services, "transportation of ... passengers by road ... transportation of human beings by means of land vehicles ... automobile and motorcycle rental services; chauffeur services."

The registrations for variations on the VIRGIN mark identify still more goods and services. Mr. Branson, the Virgin Group and the VIRGIN brands have been the subject of numerous books and features. *See, e.g.*, Opposer's Test. Exh. 212-217. Mr. Branson has appeared on numerous telecasts in the United States, including on CNN, NBC and Fox where he has promoted the VIRGIN marks. Levin-Hyams Test. at 26-35. Thus, Mr. Branson's notoriety has attracted significant attention for himself, for the companies he owns and controls and for the VIRGIN marks.

In the United States, one of the principal services opposer offers under the VIRGIN mark is airline services. Opposer has offered this service since 1984. The service has operated between the United Kingdom and certain U.S. cities, including Boston, Las Vegas, Los Angeles, Miami, Newark, New York, Orlando, San Francisco and Washington, D.C. Bershefsky Test. at 9-10. Opposer offers many "extras" with its airline service, most notably limousine service to and from airports for departure and on arrival, including at airports opposer serves in the United States. Bershefsky Test. at 27-28. The "extras" have also included an amenities kit, a catalog and magazines featuring the VIRGIN marks. James Test. at 22.

While opposer is not one of the largest air carriers operating in the United States, the

service it has provided is significant in terms of both length of service, revenue and numbers of passengers carried. *Id.* at 10 *et seq.* Opposer has conducted significant advertising related to its airline service in media including print, radio and television. *Id.* at 13. For example, opposer has run ads in major U.S. newspapers and magazines, including, *The New York Times*, *The Wall Street Journal*, *The Washington Post*, *The Boston Herald*, *The San Francisco Chronicle*, *The Los Angeles Times*, *Newsweek*, *Forbes*, *Fortune*, *The Economist*, and *Business Week*. *Id.* at 16-17.

The Virgin Group has also sold significant numbers of musical recordings under the VIRGIN mark in the United States since the early 1990s. James Testimony at 85. The Virgin Group has operated retail stores under the VIRGIN and VIRGIN MEGASTORE marks in as many as twenty major U.S. cities since 1992 (Test. Exh. 185); the Virgin Group also sells VIRGIN MEGASTORES' products online. The stores carry musical recordings, DVDs, clothing, books and magazines, games and other products. Many of the stores are located in prime, high visibility locations, such as, Times Square and Union Square in New York City, Michigan Ave. in Chicago, Mass. Ave. and Newbury St. in Boston, Market St. in San Francisco and Sunset Blvd. in Los Angeles. Block Test. at 19. The signage at these locations, as illustrated in Test. Exh. 189 showing the Time Square location, is highly visible.

Opposer has experienced substantial sales at its retail and online stores. Opposer has placed a substantial amount of advertising with regard to its stores in local and national print media, and on television and radio in the cities where the stores operate. *Id.* at 12. Over 31, 000, 000 people visited the stores in 2003. *Id.* at 19. The stores use/distribute approximately 8, 000, 000 shopping bags per year using the VIRGIN and VIRGIN MEGASTORE marks. *Id.* at 31. See Test. Exhs. 89 and 208. Opposer logs between 30, 000 to 50, 000 hits at its VIRGIN MEGASTORE web site each month. Opposer hosts approximately 300 in-store events per year at its stores. Block Test. at 51.

Opposer also provides a wide variety of communications services under the VIRGIN and VIRGIN MOBILE marks. Reg. No. 2625455, noted above, for the mark VIRGIN in standard-character form, among other services, covers "computerized communication services, namely, electronic mail services, and providing networks for the purpose of transmission and reception of electronic mail, computer generated music, news and other data and information; and broadcasting services by radio and over a global computer network of a wide variety of programs, namely, current events, economics, politics, sports, entertainment, the arts and business." Although the registration arguably does not cover cellular telephone service, Virgin Mobile renders the services referenced here, along with its cellular telephone service. Stohrer Test, at 13 and 67.

The rights conferred by the registration date from the filing date of December 17, 1998. Virgin Mobile began actively marketing its communication services in July 2002. *Id.* at 86.

Opposer uses both the VIRGIN and VIRGIN MOBILE marks consistently in the rendering of these communications services. Although, the VIRGIN MOBILE mark is not among the marks pleaded here, the VIRGIN MOBILE mark is consistently used/displayed in a manner where VIRGIN creates a distinct commercial impression apart from the generic MOBILE element which is consistently displayed less prominently and separate from VIRGIN as shown here: (Image Omitted) VIRGIN appears in the familiar script form shown above. See, *e.g.*, Opposer Test. Exhs. 135-165 and 178. Thus, opposer has used the VIRGIN mark covered by its registration in conjunction with the communications services identified in the registration.

Opposer's use of the VIRGIN mark in conjunction with communications services has been extensive. Opposer has promoted the VIRGIN mark for its communications services primarily to the youth market over a wide geographic area. *Id.* at 11. Opposer offers its communications services through 12, 000 outlets, including its own Virgin Megastores and major retailers, such as, Best Buy and Target. Opposer

has expended significant sums in advertising and promoting its VIRGIN mark in connection with its communications services. *Id.* at 6. Opposer has advertised in virtually all forms of print and electronic media, in major magazines, through radio and over national television, including MTV, BET, and Comedy Central, and on stations on the ABC, CBS, NBC and Fox networks. *Id.* at 54. Opposer has also conducted extensive promotions in relation to its communications services.

As a consequence of these efforts opposer has, in a relatively short period of time, secured significant recognition of its VIRGIN mark in connection with communications services. *Stohrer Test.* at 83.

What is most impressive about opposer's advertising and promotional activities in general is the effectiveness of its public relations activities in addition to the placement of paid advertising. This applies to its airline services, its retail services and its communications services.

The promotions take many forms. For example, opposer conducted a "Virgin Across America" road show to promote its airline services. In this promotion opposer outfitted a tractor trailer to replicate the interior of its aircraft. The tour visited numerous locations across the United States and generated substantial publicity in the process. *See, e.g., Test. Exh. 5, Bershefsky Test.* 122-123.

As we indicated, opposer conducts approximately 300 in-store events at its retail stores per year. These events include appearances by celebrities, such as recording artist Ricky Martin. *See Opposer's Test. Exh. 191, Newsday* article dated May 22, 2003.

The events also include promotions, such as one conducted in nine U.S. cities in conjunction with VOLVO, which featured the introduction of a new VOLVO model. The cars were displayed inside and outside the stores, and test drives were offered. The event featured a sweepstakes where the winner was flown from the United States to London and then Sweden

where the winner selected a VOLVO automobile which was then shipped to the winner in the United States. *Egelhoff Test.* at 29. Another similar program was conducted in the stores with BMW in 2003. *Id.* at 50. The BMW promotion was conducted at all U.S. stores, and again, BMW automobiles were given to certain individuals. *Id.* at 51.

Opposer also ran the "Virgin College MegaTour" promotional program wherein its goods and services were promoted along with the goods of other companies, including auto companies, at numerous college campuses in the United States. *Id.* at 51. There was extensive media coverage of the college tour. *Test. Exh. 54.*

The impact of these promotions is evident. The record includes copies of several hundred articles featuring the Virgin Group and its VIRGIN branded goods and services. The publications where the articles appeared run the full gamut, from national to local, from magazines to newspapers, from general interest to special interest. They include local newspapers, among others, in Columbus (OH), Las Vegas, St. Petersburg, Spokane, Austin, Reading (PA), and Grand Rapids, as well as, *The Wall Street Journal, The Boston Globe, The New York Times, The Salt Lake Tribune, Newsday, The Washington Post, and The Arkansas Democrat Gazette*, and major magazines, such as *Forbes, Women's Wear Daily, Black Enterprise, Consumer Electronics, Daily Variety, Rolling Stone, The National Enquirer, People, Harper's, Business Week*, and many others. *See Test. Exhs. 30, 218-234 and 191-193.* The subject matter of the articles ranges from Mr. Branson, the performance of the Virgin Group businesses, the Virgin Group products and services and primarily opposer's promotional activities and events. In virtually all instances the VIRGIN marks are referenced. A *Wall St. Journal* article of May 14, 2004 even discusses the opposer's environmental programs. *Test. Exh. 191.*

In sum, the record establishes that opposer's extensive and varied advertising and promotional activities have resulted in a widespread awareness of the VIRGIN marks.

Furthermore, opposer has provided an impressive record of its policing activities to enforce its rights in the VIRGIN marks. See Opposer's Notice of Rel. Exhs. 50-122.

### *B. Applicant*

Applicant is a family-owned Ford and Mercury auto and truck dealership in Albion, Michigan where applicant sells and services new and used vehicles from one location. Vann Test. at 9, 15-16. William Ward Vann is part owner and principal manager of the business. *Id.* at 15-16. Applicant also sells vehicles through its dealership online. *Id.* at 35. In addition, applicant offers vehicle rentals in conjunction with its dealership in association with ENTERPRISE car rental. *Id.* at 9.

Applicant offers a program whereby customers may custom order a vehicle either at the dealership or online. Applicant uses the VIRGIN SALE, VIRGIN VEHICLE and VIRGIN PURCHASE marks in conjunction with this program. Applicant states, "The business strategy behind custom ordered new vehicles in conjunction with the marks is based on the perceived strong association that a consumer will make with the marks to custom ordered vehicles, the manufacturing element of the word 'virgin,' and 'the newness, purity, first-time element of the custom-ordered vehicle,'" Applicant's Brief quoting from Vann Test. 54 and 64. Applicant maintains an Internet site and uses its VIRGIN marks on that site. *Id.* at 17; App. Test. Exh. 6. Applicant states the following on its web site with regard to each of its VIRGIN marks:

#### **Virgin Vehicles™**

- Any vehicle of transportation custom ordered and custom manufactured for the first end user; not previously available to others; Virgin Ford.

#### **Virgin Purchase™**

- To acquire something by custom order and custom manufactured first, genuine and pure by sacrifice (money), to acquire a

#### **Virgin Vehicle™**

#### **Virgin Sale™**

- Selling or being sold that is custom ordered and custom manufactured for and by the first end user; genuine and pure, selling a **Virgin Vehicle™**.

App. Test. Exh. 6.

Applicant has used its VIRGIN marks since 2002. Vann Test. at 25. Ford Motor Company has asked applicant not to use the term "VIRGIN" in conjunction with its FORD mark. Vann Test. at 44. Applicant generally advertises locally. *Id.* at 15-16.

### *VI. Discussion*

#### *A. Likelihood of Confusion*

We first address opposer's claim of likelihood of confusion. The opinion in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563, 567 (CCPA 1977), sets forth the factors to be considered in determining likelihood of confusion. We must determine the issue of likelihood of confusion in each case based on the evidence of record relating to the factors. *In re Majestic Distilling Co.*, 315 F.3d 1301, 65 U.S.P.Q.2d 1201, 1203-04 (Fed. Cir. 2003). Accordingly, we will discuss each of the factors as to which opposer or applicant have presented evidence or arguments.

#### **1. Fame**

We begin our discussion with the *du Pont* factor related to the fame of opposer's mark because fame of the prior mark, if it exists, plays a dominant role in likelihood of confusion cases. *Recot, Inc. v. M. C. Becton*, 214 F.3d 1322, 54 U.S.P.Q.2d 1894 (Fed. Cir. 2000).

In determining fame in this case we focus our attention on the VIRGIN mark itself, that is, VIRGIN alone in standard-character form and VIRGIN in stylized script, as shown above. We conclude that VIRGIN has achieved significant fame in the fields of airline services, in the retail store and online sale of recorded music and related products and in the field of communications. In reaching these conclusions

we have relied primarily on opposer's evidence with regard to (1) the length of time it has provided the relevant services under the VIRGIN mark, (2) the sales and advertising activities related to those services, and most importantly (3) the evidence opposer provided of the public recognition of the VIRGIN mark as used in conjunction with these services. The principal evidence of the public recognition of the mark is the evidence of the media attention opposer generated with regard to the VIRGIN mark as used in connection with these services as a result of opposer's advertising and promotional efforts. This evidence is impressive both in quality and quantity.

Applicant argues that the VIRGIN mark is not famous. Applicant questions both the quality and quantity of the evidence opposer presented to show fame. In particular, applicant asserts that opposer failed to show fame within a particular product or service category and that opposer failed to establish through its evidence that opposer is a leader in any of the fields in which it uses its mark. Applicant also asserts that opposer's evidence of fame should be rejected because it relates to a period after the filing of the applications and after the filing of these proceedings. Applicant's Brief at 19.

As to the quantity of evidence, in its argument applicant sets the bar very high. In so doing applicant fails to recognize the important difference between the standard for establishing fame for likelihood-of-confusion purposes as opposed to establishing fame for dilution purposes. As the Court of Appeals for the Federal Circuit has stated, "Fame for likelihood of confusion purposes and fame for dilution purposes, however, are distinct concepts. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q.2d 1164, 1170 (T.T.A.B. 2001). While dilution fame is an either/or proposition-fame either does or does not exist-likelihood of confusion fame 'varies along a spectrum from very strong to very weak.' *In re Coors Brewing Co.* 343 F.3d 1340, 1341 [68 U.S.P.Q.2d 1059] (Fed. Cir. 2003)." *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 73 U.S.P.Q.2d

1689, 1694 (Fed. Cir. 2005).

We have concluded that opposer has established significant fame here for purposes of our consideration of likelihood of confusion. We need not and do not consider here whether or not opposer has established the high degree of fame required as an element of a dilution claim. *Cf. NASDAQ Stock Market Inc. v. Antarctica S.r.l.*, 69 U.S.P.Q.2d 1718 (TTAB 2003); *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q. 1164, 1173 (TTAB 2001).

As to the quality of opposer's evidence, here also applicant assumes a standard which is overly rigid. Applicant dismisses sales and advertising information as being insufficient and implies that opposer must show that it is an industry leader in the field in which it claims fame.

The evidence of fame in this case, when viewed in its totality, is more than sufficient to establish the fame of the VIRGIN mark in the field of airline services, communications and in the retail store and online sale of recorded music and related products. In fact, the type of evidence of record in this case parallels the evidence of fame in the *Palm Bay* case. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 U.S.P.Q.2d at 1695. Here we have evidence of use of the VIRGIN mark over a significant period of time, significant sales and significant advertising and promotional expenditures and activities. As we noted, the evidence of public recognition of the VIRGIN mark in the media, large and small, local and national, print and electronic, general interest and special interest, is critical to our finding of fame.

Contrary to applicant's contentions, we find none of the weaknesses in the evidence here the Board noted in the *Blue Man Productions* case. *Cf. Blue Man Productions Inc. v. Tarrmann*, 75 U.S.P.Q.2d 1811, 1819 (TTAB 2005). We note, in particular, that virtually all of the many hundreds of articles are, in fact, about opposer and its services. The mentions of opposer and the VIRGIN marks are not merely passing references.

We also reject applicant's implication that opposer must establish itself as an industry leader in relevant fields to show fame. We find no support in the cases for such an inflexible approach. Such an arbitrary rule would unduly limit the consideration of legitimate evidence of fame.

We likewise reject applicant's argument regarding the fields of use. In fact, we have considered fame in relation to specific goods and services, and we have limited our conclusion with regard to fame appropriately in that regard, that is, to the fields of airline services, communications and to the retail store and online sale of recorded music and related products.

Finally, we reject applicant's contention that we should not consider opposer's evidence of fame which relates to a period after the filing of its applications or after the filing of these proceedings. We find no support for this proposition. Again, there is an important distinction between likelihood of confusion and dilution in this regard. The Trademark Act requires that a party asserting dilution in an opposition proceeding must establish that its mark had become famous prior to the filing date of an intent-to-use application. *Toro Co. v. ToroHead Inc.*, 61 U.S.P.Q. at 1174. In contrast the Trademark Act provides no such limitation in the presentation of evidence of distinctiveness. For example, Trademark Act § 2(f) simply provides that a prima facie claim of distinctiveness assert use "... for the five years before the date on which the claim of distinctiveness is made." 15 U.S.C. 1052(f). Also, the Board generally accepts and considers evidence related to likelihood of confusion and similar issues for the period up to the time of trial. We see no reason to treat evidence of fame differently. Accordingly, we have considered opposer's evidence of fame without regard to whether it relates to a time period before or after the filing of the applications at issue here or these proceedings.

Accordingly, we conclude that opposer's VIRGIN mark has achieved significant fame in the fields of airline services, communications services

and in the retail store and online sale of recorded music and related products.

The degree of fame shown here entitles opposer to a significantly broader scope of protection than would otherwise apply for its VIRGIN marks. *Gillette Canada Inc. v. Ranir Corp.*, 23 U.S.P.Q.2d 1768, 1774 (TTAB 1992). *See Kenner Parker Toys Inc. v. Rose Art Industries Inc.*, 963 F.2d 350, 22 U.S.P.Q.2d 1453, 1456 (Fed. Cir. 1992). This factor favors opposer.

## 2. The Marks

In comparing the marks we must consider the appearance, sound, connotation and commercial impression of the marks at issue. *Palm Bay Imports Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 73 U.S.P.Q.2d at 1692.

As a preliminary matter we must address opposer's claim that it has a family of VIRGIN marks. The Federal Circuit characterizes a family of marks as follows:

A family of marks is a group of marks having a recognizable common characteristic, wherein the marks are composed and used in such a way that the public associates not only the individual marks, but also the common characteristic of the family, with the trademark owner. Simply using a series of similar marks does not of itself establish the existence of a family. There must be recognition among the purchasing public that the common characteristic is indicative of a common origin of the goods.

*J & J Snack Foods Corp. v. McDonald's Corp.*, 932 F.2d 1460, 18 U.S.P.Q.2d 1889, 1891 (Fed. Cir. 1991).

The Board has specified the following requirements to establish a family of marks: "... it must be shown by competent evidence 'first, that prior to the entry into the field of the opponent's mark, the marks containing the claimed "family" feature or at least a substantial number of them, were used and promoted together by the



proponent in such a manner as to create public recognition coupled with an association of common origin predicated on the "family" feature; and second, that the "family" feature is distinctive (i.e. not descriptive or highly suggestive or so commonly used in the trade that it cannot function as the distinguishing feature of any party's mark).' *Land-O-Nod Co. v. Paulison*, 220 U.S.P.Q. 61, 65-66 (TTAB 1983)." *Marion Laboratories v. Biochemical/Diagnostics*, 6 U.S.P.Q.2d 1215, 1218 (TTAB 1988).

Although opposer refers to its family of marks in the notices of opposition, opposer does not identify which marks are members of that family in the notices. Notices of Opp. ¶¶ 19 and 22. *Cf. Marion Laboratories v. Biochemical/Diagnostics*, 6 U.S.P.Q.2d at 1216-17. Likewise, in its briefs opposer fails to identify the marks it considers within the family. Nor does opposer address the "family-of-marks" issue in general directly in its brief. Accordingly, in determining whether the VIRGIN marks constitute a family of marks, we have considered all of the marks identified in the eighteen registrations noted above as potential members of the family. Furthermore, we have considered whether "a substantial number of them were used and promoted together." *Id.* In this enormous record, we have identified a few examples of instances where a number of the VIRGIN marks appeared together. For example, in Test. Exh. 56, taken from one of opposer's web sites, we noted uses of the VIRGIN mark along with VIRGIN ATLANTIC, and VIRGIN VACATIONS, as well as a number of unpleaded variations of the VIRGIN marks, such as, VIRGIN MOBILE, and RADIOFREEVIRGIN. However, we have not found sufficient evidence of the type of use and promotion of the potential marks in the family to conclude that there is a family of VIRGIN marks. Accordingly, for purposes of our comparison of the marks in this case, we will not consider the VIRGIN marks as a family of marks. Therefore, we must compare each of opposer's VIRGIN marks at issue in this proceeding with the marks in the opposed applications.

We begin that analysis by noting that, while

we must consider the marks in their entirety, it is entirely appropriate to accord greater importance to the more distinctive elements in the marks. As the Court of Appeals for the Federal Circuit observed, "... in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entirety. Indeed, this type of analysis appears to be unavoidable." *In re National Data Corp.*, 753 F.2d 1056, 224 U.S.P.Q. 749, 751 (Fed. Cir. 1985).

With regard to opposer's marks, we first note the registrations which opposer has pleaded and made of record, shown above, which cover either VIRGIN alone in standard-character form or VIRGIN alone in stylized script, that is, ten of the eighteen registrations which are properly of record. As we noted above, these registrations, considered alone, cover a wide variety of goods and services, most notably, all of the services in connection with which we have concluded the VIRGIN mark has become famous.

Secondly, we consider those registrations for standard-character marks which consist of only the word VIRGIN and disclaimed wording which is either descriptive or generic, that is, VIRGIN MEGASTORES, VIRGIN VACATIONS, VIRGIN VODKA and VIRGIN HOLIDAYS. These four registrations add marginally to the scope of the goods and services covered by the ten registrations noted above. In fact, the ten registrations noted cover substantially all of the significant goods and services covered by the eighteen registrations.

Accordingly, for purposes of our consideration of opposer's marks, we have considered only the marks in the ten registrations noted above, those which consist of VIRGIN without any other wording or separate design element. We conclude that the word VIRGIN is either the only or the dominant element in each of these marks. The design element, that is, the script and underlining in the special-form marks, in no way detracts from the dominance of VIRGIN

in these marks. *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 41 U.S.P.Q.2d 1531, 1534 (Fed. Cir. 1997).

Likewise, in analyzing applicant's marks, VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE, we conclude that the dominant element in each of these marks is also VIRGIN. Here also, the only additional element in each case is a disclaimed term which is either descriptive or generic, VEHICLE, PURCHASE and SALE, respectively. Therefore, we conclude that the additional elements in each of these marks in no way detracts from the dominance of VIRGIN in each of applicant's marks.

Furthermore, as to the marks of both opposer and applicant before us here, we note that in each of the marks VIRGIN is the first word. *Presto Products, Inc. v. Nice-Pak Products Inc.*, 9 U.S.P.Q.2d 1895, 1897 (TTAB 1988) ("... [it is] a matter of some importance since it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered.").

The only significant arguments applicant raises with regard to the similarity or dissimilarity of the parties' marks are (1) that the marks, when viewed in their entirety, differ, and (2) that VIRGIN is a weak, suggestive term.

It is apparent from our discussion here that we reject applicant's argument regarding the comparison of the marks in their entirety. We have considered the marks in their entirety and conclude that VIRGIN is the dominant element in the marks of both parties.

Turning to applicant's argument regarding the strength of VIRGIN, we will address applicant's argument and evidence on that point below under the appropriate factor.

Finally, we have concluded that each of opposer's VIRGIN marks in the ten registrations noted here is similar to each of applicant's marks. In reaching these conclusions we have considered the marks, in every instance, in their entirety. This factor favors opposer.

### **3. The Number and Nature of Similar Marks in Use on Similar Goods.**

Applicant argues that opposer's VIRGIN marks are weak as a result of third-party uses of "virgin." At the outset we note our conclusion above that opposer's VIRGIN mark has achieved significant fame, a conclusion which necessarily requires the further conclusion that opposer's mark is strong and not weak.

Applicant introduced evidence in support of its position, specifically: records of active and dead third-party registrations, not owned by opposer, for marks which include "VIRGIN"; records of live and dead approved, pending applications fitting the same description; records of Board proceedings brought by opposer against marks which include "VIRGIN"; copies of certain responses by opposer to applicant's discovery; certain exhibits from opposer's testimony deposition of Mr. Vann; and examples of various uses of "virgin" in publications. Applicant introduced all of this evidence by notice of reliance. We have reviewed all of the evidence carefully and conclude that it fails to establish that opposer's VIRGIN mark is weak.

First we note that third-party registrations are entitled to little weight on the question of likelihood of confusion. *See, e.g., In re Hub Distributing, Inc.*, 218 U.S.P.Q. 284 (TTAB 1983). Such registrations are not evidence that the marks are in use or that the public is familiar with them. *See, e.g., AMF Inc. v. American Leisure Products, Inc.*, 474 F.2d 1403, 177 U.S.P.Q. 268 (CCPA 1973). As the Federal Circuit has stated, "[t]he probative value of third-party trademarks depends entirely upon their usage." *Palm Bay Imports, Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 73 U.S.P.Q.2d at 1693. As to the dead registrations, such registrations ordinarily have no evidentiary weight. *See Mattel, Inc. v. Funline Merchandise Co., Inc.*, 81 U.S.P.Q.2d 1372 (TTAB 2006). Likewise, records of pending applications, regardless of status, lack probative value for our purposes here.

Furthermore, the active registrations applicant submitted provide no support for its

position. First, the majority of the registrations involve marks which simply have no relevance to the issues in these proceedings. The majority of the active registrations, all but five of the forty-two provided, involve marks which either (1) include VIRGIN or EXTRA VIRGIN used generically as applied to olive oil or similar goods, or (2) marks which include VIRGIN ISLANDS used in its geographical sense.

The remaining five registrations are: VIRGIN SPRINGS for bottled water (Applicant's Not. of Rel. Exh. 3); VIRGIN BOURBON for whiskey (Exh. 5); K PORT NATURAL SPRING WATER EXTRA VIRGIN and design with "EXTRA VIRGIN" disclaimed for natural spring water (Exh. 18); VIRGIN HAIR & AFRO on the Supplemental Register with "VIRGIN HAIR" disclaimed for hair styling preparations and skin moisturizers (Exh. 33); and REBORN VIRGIN for books (Exh. 34). Even if we were to presume that these marks were in use, and we do not, the use would be insufficient to establish that opposer's VIRGIN marks are weak.

The records of the proceedings brought by opposer with regard to third-party VIRGIN marks, in fact, provide evidence of opposer's policing efforts and, on balance, support the conclusion that opposer's VIRGIN mark is a strong mark.

As to the publications, the only exhibits which have any relevance with regard to the strength or weakness of opposer's mark are: a *Chicago Tribune* article referencing the EXTRA VIRGIN restaurant opening eight weeks earlier in Chicago (Exh. 205); an article from the *Washington Times* referencing the opening of another EXTRA VIRGIN restaurant in Virginia (Exh. 106); and an item from the *Las Vegas Review Journal* referencing a contract involving "the Virgin River hotel-casinos in Mesquite" (Exh. 207). (Ex. 218 refers to the Virgin mountains and the Virgin River Gorge in Arizona which may be related.)

The remainder of the publications include uses of "virgin" in its descriptive or generic sense, not as a mark or even part of a mark -- for example, "virgin snow" (Exh. 220), "virgin

aluminum" (Exh. 255), "virgin iron ore" (Exh. 256) and "virgin forest" (Exh. 269). Applicant also includes a dictionary definition of "virgin" (Exh. 201). Furthermore, applicant includes exhibits related to its own use from the Vann deposition to support its general argument that opposer's VIRGIN marks are weak, arguing that its own uses are suggestive.

We find none of applicant's evidence intended to show that opposer's VIRGIN mark is weak persuasive. The fact that "virgin" has a dictionary meaning and is used in its dictionary sense in no way precludes a party, such as opposer, from adopting it as a mark and developing a strong or famous mark. *Chicago Bears Football Club Inc. v. 12<sup>th</sup> Man/Tennessee LLC*, 83 U.S.P.Q.2d 1073, 1081-82 (TTAB 2007). Applicant's evidence shows either use of "virgin" in its dictionary sense, and a few isolated potential uses of "virgin" in marks. There is no evidence of any significant use by third parties of VIRGIN marks. Furthermore, we have no evidence that applicant's own use of VIRGIN in the marks at issue here, whether suggestive or not, has in any way detracted from the strength of opposer's VIRGIN marks. Accordingly, we conclude that opposer's VIRGIN mark is a strong mark possessing a significant degree of fame. This factor favors opposer.

#### **4. The Goods and Services and Channels of Trade**

The goods and services of opposer and applicant need not be identical to find likelihood of confusion under Section 2(d) of the Trademark Act. They need only be related in such a way that the circumstances surrounding their marketing would result in relevant consumers mistakenly believing that the goods or services originate from the same source. *In re International Telephone & Telegraph Corp.*, 197 U.S.P.Q. 910, 911 (TTAB 1978). *See also On-Line Careline Inc. v. America Online Inc.*, 229 F.3d 1080, 56 U.S.P.Q.2d 1471 (Fed. Cir. 2000).

Furthermore, in comparing the goods and services we must consider the goods and services as identified in the application and

registrations. See *Octocom Systems, Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 U.S.P.Q.2d 1783, 1787 (Fed. Cir. 1990) ("The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.") See also *Paula Payne Products v. Johnson Publishing Co.*, 473 F.2d 901, 177 U.S.P.Q. 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods.").

Applicant argues that its "automobile and truck dealerships" are far removed from any of the goods and services offered by opposer under its VIRGIN marks. Applicant states, "In response to discovery requests, VEL [opposer] acknowledged that it does not have a retail facility for selling vehicles in the United States, that it has never sold vehicles in the United States, and that it possesses no documents evidencing plans to utilize any mark with the term VIRGIN in association with the retail sale of automobiles and trucks in the United States. (App. NOR EXS. 198-200)." Applicant's Brief at 9. Applicant also points out that certain Virgin Group officials indicated in testimony that they had no knowledge of any Virgin Group plans to sell vehicles in the United States. *Id.* at 10-11. Applicant also asserts that opposer failed to provide any evidence that opposer's goods and services are related to applicant's services.

On the other hand, opposer states, "The services specified in the opposed applications, "automobile and truck dealerships," are closely related to automobile transportation, retail store, and online shopping services recited in Opposer's registrations and actually provided by the Virgin Group companies as described above." Opposer's Brief at 27. Opposer also points to its BMW and Volvo promotions as evidence that the goods and services of the parties are related.

We conclude that the goods and services

identified in opposer's eighteen registrations are related to the automobile and truck dealership services identified in the applications at issue in view of the wide variety of goods and services identified in opposer's registrations and the fame of the VIRGIN mark. We might reach a different conclusion if we looked at each of opposer's goods and services in isolation in relation to applicant's services. However, the circumstances surrounding the marketing of opposer's goods and services when viewed as a whole, that is, considering the wide variety in opposer's goods and services, and the fame of opposer's mark, lead us to conclude that relevant purchasers would perceive that the goods and services of the parties are related.

Below, we discuss further the impact of opposer's use of its VIRGIN marks on the wide variety of goods and services identified in the registrations under eighth *du Pont* factor.

Although opposer did present evidence of its use of the VIRGIN mark in the United Kingdom in conjunction with the sale of automobiles, that use is not relevant for purposes of these proceedings and we have not considered that use in reaching our conclusion here. We reject opposer's argument that those activities somehow extend into the United States. We note that none of the registrations which are of record here cover those services, nor did opposer otherwise plead use of its mark on such services in the United States.

We also agree with applicant that the mere fact that one can navigate from opposer's sites to sites which do offer cars for sale establishes the necessary relationship in the minds of consumers between opposer's goods and services and applicant's automobile and truck dealerships and we have not relied on that evidence in reaching our conclusion here. The relationship here is too attenuated; taken to its logical limit, the argument would support a relationship between virtually any goods or services which are offered online.

Likewise, we agree with applicant that opposer's limited sales of vehicles used by Virgin Limo fails to establish that the goods and services

of the parties are related. Again, opposer did not plead that it used its VIRGIN mark in the sale of automobiles, nor is this service covered by opposer's registrations which are before us in these proceedings. Furthermore, the sales of cars here is merely incidental to the rendering of the limousine service. The cars were merely purchased for use in conducting the business and disposed of when they were no longer suitable for such use.

On the other hand, applicant attaches undue probative value to the statements by opposer's witnesses that they had no knowledge of any plans by opposer to sell automobiles or trucks under the VIRGIN mark in the United States. This testimony is not probative of the perception of relevant purchasers. In fact, the record includes a *Wall Street Journal* article discussing opposer's innovative methods for selling automobiles of varied manufacturers under the VIRGIN mark in the United Kingdom. The article discusses both opposer's interest in the doing the same in the United States and obstacles in bringing that business to the United States. This article shows that at least some people in the United States may be aware of opposer's use of the VIRGIN mark in relation to automobile sales and the possibility it might do so in the United States. We hasten to add that it is the wide variety of opposer's goods and services and the fame of its mark which leads us to conclude that the goods and services of the parties are related, and not this specific evidence.

Accordingly, we conclude that the goods and services of the parties are related. This factor favors opposer.

Turning to the channels of trade, here also we must look to the goods and services identified in the registrations and applications of the parties to determine whether there are related. *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 U.S.P.Q. 198, 199 (Fed. Cir. 1983); *In re Melville Corp.*, 18 U.S.P.Q.2d 1386, 1388 (TTAB 1991).

Based on the same analysis we conducted with regard to the parties' goods and services, we conclude that the channels of trade are related.

Applicant's goods and services, as identified, for the most part would be sold or rendered to the general public. Applicant's services, as identified, would also be rendered to the general public. Again, the wide variety of opposer's goods and services likewise travel in varied trade channels. Under the circumstances potential customers are likely to perceive that the trade channels could extend to applicant's trade channels. Accordingly, we also conclude that the parties' trade channels are related. This factor favors opposer.

## **5. The Variety of Goods on Which a Mark is Used**

The *du Pont* case directs us to consider evidence regarding the variety of goods [or service] with which the mark is used under the eighth *du Pont* factor. As already discussed, in this case we have significant evidence on this factor. As we noted above, the eighteen registrations on which opposer relies identify a wide variety of goods and services covering a diverse collection of goods and services. *Time Warner Entertainment Co. v. Jones*, 65 U.S.P.Q.2d 1650, 1662 (TTAB 2002). The registrations which cover the VIRGIN mark by itself either in standard form or script identify services ranging from transportation and travel, to bar services, to communications services, to online sales and retail store services for a wide variety of goods. The goods identified in these registrations range from audio and video recordings in varied forms, to clothing, to luggage, to publications, to stationary and office supplies, to alcoholic and nonalcoholic beverages. On the basis of these registrations we conclude that opposer's goods and services include a wide variety and that this factor favors opposer.

We also note the significance of this factor in our overall analysis - if consumers have been exposed to use of a mark, especially a famous mark, on a wide variety of goods and services from one party they are more likely to believe that the use of the mark has been extended by the same party to additional goods or services.

## **6. Actual Confusion**

Applicant argues that there has been no actual confusion, presumably to support its position that there is no likelihood of confusion. Applicant's Brief at 28. It is not necessary to show actual confusion in order to establish likelihood of confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, 902 F.2d 1546, 223 U.S.P.Q. 1025 (Fed. Cir. 1990).

In this case, Mr. Vann, who is an owner of applicant and the only witness connected with applicant, states that applicant used its VIRGIN marks since 2002; he is noncommittal as to any earlier use. Vann Test. at 25. Applicant operates from a single location in Albion, Michigan and generally advertises locally. *Id.* at 15-16. Applicant maintains an Internet site and uses its VIRGIN marks on that site. *Id.* at 17; Test. Exh. 34. Mr. Vann indicated that so far as he knew applicant did not maintain records regarding the numbers of visitors to applicant's web site. *Id.* at 24. The applications at issue here are intent-to-use applications; the record shows use of the marks in a limited area for a limited period of time. We have no evidence regarding the impact of the use of the marks on the Internet. Accordingly, on this record, we must conclude that the opportunity for confusion is minimal.

Under the circumstances, the absence of actual confusion is of little or no probative value with regard to the likelihood of confusion. The Federal Circuit has stated, "A showing of actual confusion would of course be highly probative, if not conclusive, of a high likelihood of confusion. The opposite is not true, however. The lack of evidence of actual confusion carries little weight (citation omitted) . . ." *Majestic*, 65 U.S.P.Q.2d at 1205. See also *In re Kangaroos U.S.A.*, 223 U.S.P.Q. 1025, 1026-27 (TTAB 1984).

Accordingly, we conclude that the actual-confusion factor is neutral in this case.

## **7. Purchaser Sophistication**

Applicant states, "Further, the Board will recognize that automobiles and trucks are expensive goods and consumers and potential consumers of Albion Motors' services are, thus,

elevated to the standard of 'discriminating purchasers.'" (Citations omitted.) Applicant's Brief at 24. Opposer disagrees and notes, among other things, the potential for initial interest confusion. Opposer's Reply Brief at 15.

We agree with applicant's point that potential purchasers of automobiles and trucks are likely to exercise a higher degree of care than purchasers of less expensive items. However, those purchasers would include the general public; the class of purchasers is not restricted to persons possessing special knowledge or expertise. Even sophisticated purchasers are not immune from trademark confusion. *In re Decombe*, 9 U.S.P.Q.2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 U.S.P.Q. 558 (TTAB 1983).

On this record, on balance we conclude that applicant's customers are not less likely to be confused as a result of the higher level of care associated with vehicle purchases. Accordingly, we conclude that the evidence in this application bearing on the sophistication of the potential purchasers fails to indicate a diminished likelihood of confusion. This factor is neutral.

## **8. Bad Faith**

Opposer has suggested, at least indirectly, that applicant adopted its VIRGIN marks in bad faith. Applicant disputes this implication. We must look to the record to see whether opposer has established bad faith. See *Recot Inc. v. M.C. Becton*, 54 U.S.P.Q.2d at 1899; *Blue Man Productions Inc. v. Tarmann*, 75 U.S.P.Q.2d at 1820. Although Mr. Vann was somewhat evasive in responding to questions regarding applicant's intent in adopting the marks, we conclude that there is no evidence here of bad faith.

Therefore, we have not considered bad faith as a factor in this case.

## **9. Conclusion**

We have considered all evidence properly of record in these proceedings bearing on the factors set forth in *du Pont* and conclude that

---

there is a likelihood of confusion between opposer's VIRGIN marks when used in connection with the goods and services identified in the registrations relied upon here and applicant's VIRGIN VEHICLE, VIRGIN PURCHASE and VIRGIN SALE marks for automobile and truck dealerships. We conclude so principally based on the similarity of the marks of the parties, the fame of opposer's mark and the variety of goods and services with which opposer's mark is used. We note finally that we have given full consideration to all competent evidence and all arguments raised in this case whether or not we have discussed them specifically.

*B. Dilution*

Opposer also asserts dilution as a ground for opposition. In view of our decision to sustain the oppositions on the ground of likelihood of confusion, it is not necessary for us to consider opposer's dilution claim.

**Decision:** The opposition is sustained on the ground of likelihood of confusion and registration is refused in each of the three applications in these proceedings.

## **CERTIFICATE OF SERVICE**

I hereby certify that I served the foregoing on Opposer's counsel of record by email transmission to [nancy.stephens@foster.com](mailto:nancy.stephens@foster.com), pursuant to Trademark Rule § 2.119(b), 37 C.F.R. § 2.119(b).

Dated: December 30, 2020

s/ Michael P. Matesky, II  
Michael P. Matesky, II